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ONE PAGE SUMMARIES

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Preface

This publication contains one page summaries of almost all decisions of the Court of Justice of the European Union (CJEU) on trade mark law. Most decisions relate to the interpretation of the Trade Mark Directive and/or the Community Trade Mark Regulation. A few decisions concerning related subjects have also been included.

The relevant rule of law and a representation of the facts of most decisions is summarised in just a few sentences. This is followed by a more elaborate summary, consisting mostly of relevant quotations. A chronological index is included at the end of this publication.

This publication is meant as a first introduction to and a brief survey of European trade mark case-law. Please always consult the full texts when appropriate. The full text of all decisions (after 1996) can be found on the CJEU website: www.curia.europa.eu.

This publication was compiled with the help of colleagues at Klos Morel Vos & Schaap. Decisions rendered after 1 Januari 2014 have not been included.

In cooperation with legal publisher deLex, a database will be created of all summaries and all full text decisions (also from before 1996). New decisions of the CJEU will be summarized and published shortly after they are handed down.

Any suggestions for revision are welcome at the following e-mail address: dirk.visser@kmvs.nl

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Wrigley filed an application with OHIM for registration of the word combination Doublemint for goods of inter alia classes 3, 5 and 30 and in particular for chewing gum (without any proof of acquired distinctiveness).

See also: Biomild and Postkantoor

Doublemint

(descriptive marks)

CJEU 23 October 2003, case C-191/01 P, Wrigley/OHIM; Doublemint

Article 7(1)(c) Trade Mark Regulation.

A word cannot be registered as a trade mark if it designates a characteristic of the goods or services concerned in one of its potential meanings.

‘By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) [Trade Mark Regulation] pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) [Trade Mark Directive], [Windsurfing Chiemsee, paragraph 25, Linde and others, paragraph 73]).’ (Para. 31).

‘In order for OHIM to refuse to register a trade mark under Article 7(1)(c) [Trade Mark Regulation], it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.’ (Para. 32).



Biomild

(descriptive composite word)

CJEU 12 February 2004, case C-265/00, Campina Melkunie/BMB; Biomild

Article 3(1)(c) Trade Mark Directive

A combination of descriptive words is also descriptive itself, unless there is a perceptible difference between the neologism and the mere sum of its parts.

Dutch dairy producer Campina filed an application with the Benelux Office for Intellectual Property (BOIP) to register the composite word Biomild as trade mark for goods of classes 29, 30 and 32 (various food products including dairy products). The product marketed in the Netherlands under this mark was a 'natural' yogurt with a mild taste.

See also: Doublemint and Postkantoor

When examining whether a composite word is descriptive it does not suffice to define the descriptive nature of the elements of the combination; for the new word itself its descriptive nature has to be established.

A mark which consists of a new word which is constituted by elements which as such constitute a description of the goods or services which the registration is applied for, constitutes itself also a description of the characteristics of such goods or services in the sense of Article 3(1)(c), 'unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.

For the purposes of determining whether the ground for refusal set out in Article 3(1)(c) [Trade Mark Directive] applies to such a mark, it is irrelevant whether or not there are synonyms capable of designating the same characteristics of the goods or services referred to in the application for registration.' (Operative part).

Postkantoor

(descriptive word)

CJEU 12 February 2004, case C-363/99, KPN/BMB; Postkantoor
Article 3 Trade Mark Directive

Refusal to register a descriptive word: existence of synonyms is not relevant. Registration in other countries is not relevant. A combination of descriptive words must have something extra. Disclaimers are not allowed.

Koninklijke KPN Nederland, the Dutch post office, filed an application with Benelux Office for Intellectual Property (BOIP) for the registration of the word 'Postkantoor' (post office) for classes which include paper, advertising, insurance, postage-stamps, construction, telecommunications, transport, education and technical information and advice.

See also: Doublemint and Biomild

1. Taking into account all relevant facts and circumstances. 'Article 3 [Trade Mark Directive] [...] is to be interpreted as meaning that a trade mark registration authority must have regard, in addition to the mark as filed, to all the relevant facts and circumstances. It must have regard to all the relevant facts and circumstances before adopting a final decision on an application to register a trade mark. A court asked to review a decision on an application to register a trade mark must also have regard to all the relevant facts and circumstances, subject to the limits on the exercise of its powers as defined by the relevant national legislation.'

2. Registration in another Member State not relevant. 'The fact that a trade mark has been registered in a Member State in respect of certain goods or services has no bearing on the examination by the trade mark registration authority of another Member State of an application for registration of a similar mark in respect of goods or services similar to those in respect of which the first mark was registered.'

3. Existence of synonyms not relevant. 'Article 3(1)(c) [Trade Mark Directive] precludes registration of a trade mark which consists exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services in respect of which registration is sought, and that is the case even when there are more usual signs or indications for designating the same characteristics and regardless of the number of competitors who may have an interest in using the signs or indications of which the mark consists.'

Where the applicable national law provides that the exclusive right conferred by registration, by a competent authority in an area in which a number of officially recognised languages coexist, of a word mark expressed in one of those languages extends automatically to its translation in the other languages, the authority must ascertain as regards each of those translations whether the mark actually consists exclusively of signs or indications which may serve, in trade, to designate characteristics of those goods or services.'

4. Descriptiveness for specific goods does not result in distinctiveness for other goods.

‘Article 3(1) [Trade Mark Directive] must be interpreted as meaning that a mark which is descriptive of the characteristics of certain goods or services but not of those of other goods or services for the purposes of Article 3(1)(c) [Trade Mark Directive] cannot be regarded as necessarily having distinctive character in relation to those other goods or services for the purposes of subparagraph (b) of the provision.

It is of no relevance that a mark is descriptive of the characteristics of certain goods or services under Article 3(1)(c) [Trade Mark Directive] when it comes to assessing whether the same mark has distinctive character in relation to other goods or services for the purposes of Article 3(1)(b) of the Directive.’

5. A combination of descriptive words must have added value.

‘Article 3(1)(c) [Trade Mark Directive] must be interpreted as meaning that a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of the characteristics of those goods or services for the purposes of that provision, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that because of the unusual nature of the combination in relation to the goods or services the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the latter case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purposes of the same provision.

For the purposes of determining whether Article 3(1)(c) [Trade Mark Directive] applies to such a mark, it is irrelevant whether or not there are synonyms capable of designating the same characteristics of the goods or services mentioned in the application for registration or that the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary.’

6. Disclaimers are not allowed.

‘[The Trade Mark Directive] prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic.’

7. All inadmissible marks should be refused.

‘The practice of a trade mark registration authority which concentrates solely on refusing to register manifestly inadmissible marks is incompatible with Article 3 [Trade Mark Directive].’ (Operative part quoted in full).

Chiemsee

(geographical name, acquired distinctiveness)



CJEU 4 May 1999, cases C-108/97 and C-109/97, Windsurfing Chiemsee/Huber

Article 3(1)(c) and (3) Trade Mark Directive

A geographical name cannot be a trade mark if it may serve to designate a geographical origin. Registration based on acquired distinctiveness is possible.

Windsurfing Chiemsee owns the word and figurative mark Chiemsee for clothing and objects to the use of the name 'Chiemsee' on clothing by Huber and Attenberger in the surroundings of the Chiemsee (the largest lake in Bavaria, Germany).

'Article 3(1)(c) [Trade Mark Directive] [...] does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question; it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods'. (Para. 37).

'A geographical name may be registered as a trade mark if, following the use which has been made of it, it has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings. Where that is the case, the geographical designation has gained a new significance and its connotation, no longer purely descriptive, justifies its registration as a trade mark.' (Para. 47).

'In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.' (Para. 51).



Have a break

(acquired distinctiveness of a slogan)

CJEU 7 July 2005, case C-353/03, Mars/Nestlé; Have a break

Article 3(3) Trade Mark Directive

The distinctive character of a mark may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.

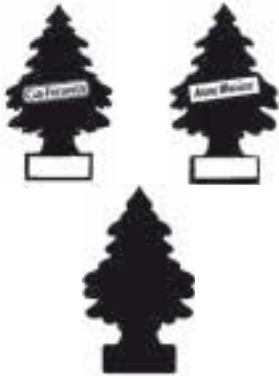
Mars objected to the registration of the slogan 'have a break' on the basis of lack of distinctive character, because this slogan had not been used separately by Nestlé, but only as part of the combination 'Have a break, have a Kit Kat'.

Article 3(3) of the Directive contains no restriction to 'separate use', referring solely to the 'use which has been made' of the mark.

'The expression 'use of the mark as a trade mark' must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking. (Para. 29).

Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.' (Para. 30).

'The distinctive character of a mark referred to in Article 3(3) [Trade Mark Directive] [...] may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.' (Operative part).



Opposition to the figurative mark of Aire Limpio based on the earlier Community, national and international figurative marks representing a fir tree with various names.

L & D/ OHIM & Julius Sämann

(acquired distinctiveness)

CJEU 17 July 2008, case C-488/06 P, L & D/OHIM & Julius Sämann

Article 8(1)(b) and 73 Trade Mark Directive

Acquisition of the distinctive character of a mark may also be as a result of its use as part of another registered trade mark.

The Court of Justice has already held that the acquisition of the distinctive character of a mark may also be as a result of its use as part of another registered trade mark. It is sufficient that, in consequence of such use, the relevant class of persons actually perceives the product or service, designated by the mark, as originating from a given undertaking. (Para. 49).

Inasmuch as L & D further submits that the assessment of the Court of First Instance, according to which the silhouette of a fir tree plays a predominant role in the ARBRE MAGIQUE mark, diverges from the case-law of the Court of Justice, it need only be stated that, contrary to what the appellant asserts, that case-law does not in any way show that, in the case of mixed trademarks comprising both graphic and word elements, the word elements must systematically be regarded as dominant. (Para. 55).

The Court of First Instance established that [the] mark has acquired a particularly distinctive character in Italy because of its well-known nature in that Member State, which stems in particular from its prolonged use as part of the ARBRE MAGIQUE mark and the well-known nature of that latter mark in Italy. (Para. 66).

In those circumstances, even if L & D could rely on the argument that mark No 91 991 possesses merely a very weak inherent distinctive character, since it consists of the shape of the product which is sold under that mark and that shape is necessary to obtain the de-sired technical result, the fact remains that such an argument, even if it were well founded, could not, in any event, cast doubt on the finding made by the Court of First Instance that that mark has acquired a particularly distinctive character in Italy because it is well known in that Member State. (Para. 67).

Europolis

(distinctive character)

**CJEU 7 September 2006, case C-108/05, Bovemij/BMB;
Europolis**

Article 3(3) Trade Mark Regulation

The distinctive character of a trade mark must be proven in the entire territory where a ground of refusal exists.

Registration in the Benelux for the trade mark EUROPOLIS will be refused, based on the fact the trade mark is not integrated in all countries of the Benelux.

Article 3(3) of the Directive must be interpreted as meaning that the registration of a trade mark can be allowed on the basis of that provision only if it is proven that that trade mark has acquired distinctive character through use throughout the territory of the Member State or, in the case of Benelux, throughout the part of the territory of Benelux in which there exists a ground for refusal. (Operative part in 1).

As regards a mark consisting of one or more words of an official language of a Member State or of Benelux, if the ground for refusal exists only in one of the linguistic areas of the Member State or, in the case of Benelux, in one of its linguistic areas, it must be established that the mark has acquired distinctive character through use throughout that linguistic area. In the linguistic area thus defined, it must be assessed whether the relevant class of persons, or at least a significant proportion thereof, identifies the product or service in question as originating from a particular undertaking because of the trade mark. (Operative part in 2).

Audi/OHIM

(slogan)

**CJEU 21 January 2010, case C-398/08 P, Audi/OHIM;
Vorsprung durch Technik**

Article 7(1)(b) and 63 Trade Mark Directive



Audi
Vorsprung durch Technik

*OHIM refused the slogan
'Vorsprung durch Technik',
made by Audi, as a trade mark.*

*A widely known slogan which possess a certain originality and resonance,
which makes it easy to remember, can be a trade mark.*

All marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks convey by definition, to a greater or lesser extent, an objective message. It is clear that those marks are not, by virtue of that fact alone, devoid of distinctive character. In so far as those marks are not descriptive for the purposes of Article 7(1)(c) of Regulation No 40/94, they can express an objective message, even a simple one, and still be capable of indicating to the consumer the commercial origin of the goods or services in question. That can be the position, in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public. (Para. 56-57).

Even if it were to be supposed that the slogan 'Vorsprung durch Technik' conveys an objective message to the effect that technological superiority enables the manufacture and supply of better goods and services, that fact would not support the conclusion that the mark applied for is devoid of any inherently distinctive character. However simple such a message may be, it cannot be categorised as ordinary to the point of excluding, from the outset and without any further analysis, the possibility that that mark is capable of indicating to the consumer the commercial origin of the goods or services in question. (Para. 58).

In that context, it should be pointed out that that message does not follow obviously from the slogan in question. As Audi observed, the combination of words 'Vorsprung durch Technik' (meaning, inter alia, advance or advantage through technology) suggests, at first glance, only a causal link and accordingly requires a measure of interpretation on the part of the public. Furthermore, that slogan exhibits a certain originality and resonance which makes it easy to remember. Lastly, inasmuch as it is a widely known slogan which has been used by Audi for many years, it cannot be excluded that the fact that members of the relevant public are used to establishing the link between that slogan and the motor vehicles manufactured by that company also makes it easier for that public to identify the commercial origin of the goods or services covered. (Para. 59).

OTHER CASES ON DISTINCTIVE CHARACTER OF WORD (AND FIGURATIVE) MARKS

Article 3(1)(d)
Trade Mark Directive
Article 7(1)(b), (c) and (d)
Trade Mark Regulation

CJEU 29 September 2001, case C-383/99 P, P&G/OHIM; Baby-dry

According to the CJEU, Baby-dry was wrongfully refused as a Community trade mark for nappies under Article 7(1)(c) Trade Mark Regulation.

‘As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.’ (Para. 40).

Please Note: It is generally assumed that this decision in effect has been rendered obsolete by the decisions concerning Doublemint, Biomild and Postkantoor.

CJEU 4 October 2001, case C-517/99, Merz & Krell/OHIM; Bravo

The Bundespatentgericht refused the word mark Bravo for stationary under Article 3(1)(d) of the Trade Mark Directive, because the word ‘bravo’ is for the relevant public purely an expression of applause. CJEU: ‘However, registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use. It is for the national court to determine in each case whether the signs or indications have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark.’ (Para. 40).

CJEU 19 September 2002, case C-104/00 P, Deutsche Krankenversicherung/OHIM; Companyline

Companyline is in the English language territory a descriptive combination which does not have a distinctive character for (a ‘line’ of) insurance products for undertakings (‘companies’).

‘What is in question here is a word mark composed of two descriptive terms, where the combination of the two components does not embody any element of fancifulness overlaying the descriptive content of the word. The descriptive meaning is unambiguous and immediately discernible without the need for any analytical effort.’ (Para. 19).

CJEU 5 February 2004, case C-150/02 P, Streamserve/OHIM; Streamserve

The Court of First Instance considered, on the one hand, that the word Streamserve was made up of a basic verb (serve) and a noun (stream) and was therefore not unusual for the consumers concerned. On the other hand, it found that the word Streamserve referred to a technique for transferring digital data from a server, enabling them to be processed as a steady and continuous stream, and that this technique

did not merely constitute a field in which those goods are applied but rather one of their specific functions. Therefore, it concluded that the word Streamserve could serve to designate a characteristic of the majority of the goods listed in the application for registration [in class 9] and that, therefore, in respect of those goods, the absolute ground for refusal set out in Article 7(1)(c) [Trade Mark Regulation] prevented its registration. In contrast, the Court of First Instance found that OHIM had established neither that Streamserve could be descriptive nor that it was devoid of distinctive character for goods within the categories manuals and publications.’ (Paras. 14-17).

‘In finding, [...], that Article 7(1)(c) [Trade Mark Regulation] pursues an aim which is in the public interest, namely that the proposed signs and indications may be freely used by all, the Court of First Instance did not fail to take account of the objectives of those provisions and accordingly interpreted them correctly.’ (Para 26).

CJEU 5 February 2004, case C-326/01 P, Telefon & Buch/OHIM; Universaltelefonbuch

In German, the words ‘Universaltelefonbuch’ and ‘Universalkommunikationsverzeichnis’ mean ‘universal telephone directory’ and ‘universal communications directory’. They are properly formed in accordance with the grammatical rules of the German language and composed of common German words. The combinations of the words Telefonbuch and Kommunikationsverzeichnis designate the kind of goods and the intended use of the services in relation to which the application is filed and they can therefore be regarded as descriptive of those goods and services.

CJEU 16 September 2004, case C-329/02 P, Sat.1/OHIM; Sat.2

Sat.2 is a combination of a common abbreviation for ‘Satellite’ with a number, but may nevertheless have distinctive character for a television channel. ‘The frequent use of trade marks consisting of a word and a number in the telecommunications sector indicates that that type of combination cannot be considered to be devoid, in principle, of distinctive character.’ (Para. 40). The Community Mark has meanwhile been registered on 6 February 2006.

CJEU 16 September 2004, case C-404/02, Nichols/Registrar of Trade Marks; Nichols

A common family name may be a trade mark as such.

‘In the context of Article 3(1)(b) [Trade Mark Directive] [...], the assessment of the existence or otherwise of the distinctive character of a trade mark constituted by a surname, even a common one, must be carried out specifically, in accordance with the criteria applicable to any sign covered by Article 2 of that directive, in relation, first, to the products or services in respect of which registration is applied for and, second, to the perception of the relevant consumers. The fact that the effects of registration of the trade mark are limited by virtue of Article 6(1)(a) of that directive has no impact on that assessment.’ (Operative part).

CJEU 5 October 2004, case C-192/03 P, Alcon/OHIM; BSS

The CJEU confirmed that the Court of First Instance had applied Article 7(1)(d) of the Regulation correctly, while ‘considered that the term BSS had, by the date of filing of the appellant’s application for registration of the mark BSS, become a current generic term among the public targeted by the goods concerned, namely ophthalmologists and ophthalmic surgeons, for a balanced salt solution. That was apparent from a number of scientific dictionaries and articles, and from the fact that various companies marketed ophthalmic products under designations containing the term BSS.’ (Para. 13).

‘In considering that the BSS mark consisted exclusively of signs or indications which had become customary in the current language of the target public to designate the goods for which that mark had been registered, and that it had been lawfully declared invalid on that ground by the contested decision, the Court of First Instance correctly pointed out, [...], that it was not the descriptive nature of the mark that was decisive but current usage in the sectors covering trade in those goods.’ (Para. 28).

CJEU 21 October 2004, case C-64/02 P, Erpo/OHIM; Das Prinzip der Bequemlichkeit

Slogans may be registered as a trade mark and no other/stricter criteria apply to their distinctive character. However, one should take into account ‘the fact that average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogan’ (Para 34) (The CJEU confirmed the decision of the CFI to quash the decision of the Board of Appeal to apply stricter criteria.) See meanwhile Board of Appeal 27 January 2006 (R 392/1999-2): mark accepted and registered.



See also: CJEU 28 April 2004, case C-3/03 P, Matratzen Concord/OHIM-Hukla.

CJEU 9 March 2006, case C-421/04, Matratzen Concord/Hukla; Matratzen

‘Matratzen’ can be a valid trade mark in Spain for mattresses even if it is fully descriptive for mattresses in German.

‘Article 3(1)(b) and (c) of [Trade Mark Directive] [...] does not preclude the registration in a Member State, as a national trade mark, of a term borrowed from the language of another Member State in which it is devoid of distinctive character or descriptive of the goods or services in respect of which registration is sought, unless the relevant parties in the Member State in which registration is sought are capable of identifying the meaning of the term.’ (Operative part).



CJEU 15 September 2005 case C-37/03 P, BioID/OHIM; BioID

‘BioID’ is the abbreviation of the adjective ‘biometrical’ and of the noun ‘identification’, and thus, as a whole, means ‘biometrical identification’. ‘Therefore, that abbreviation, which is indistinguishable from the goods and services covered by the trade mark application, is not of a character which can guarantee the identity of the origin of the marked product or service to the consumer or end-user from the viewpoint of the relevant public’.

‘In addition, in the light of the recurrent nature of the typographical features of the abbreviation BioID and the absence of any particular distinctive element, the characters in ‘Arial’ typeface and characters of different boldness do not enable the trade mark applied for to guarantee, to the relevant public, the identity of the origin of the goods and services covered by the trade mark application.

Furthermore, the two graphic elements placed after the abbreviation BioID, namely a full stop (●) and a sign (®), do nothing to enable the relevant public to distinguish, without any possibility of confusion, the products or services covered by the trade mark application from others which have another origin. It follows that those graphic elements are not capable of fulfilling the essential function of a trade mark, [...], in relation to the relevant goods and services.’ (Paras. 70-72).

ECJ 15 March 2012, C-90/11 en C-91-11, Alfred Strigl/Marke- namt en Securvita/Öko-Invest

In these consolidated German cases registration was sought for, respectively, and on the other hand an action for cancellation was filed for the trade marks ‘Multi Markets Fund MMF’ and ‘NAI – Der Natur-Aktien-Index’. In the financial sector ‘Multi Markets Fund’ refers to a fund which invest in various financial markets. The combination of letters “NAI” is short for “Natur-Aktien-Index”.

The essence of the matter deals with a descriptive sign combined with its abbreviation.

‘Article 3(1)(b) and (c) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that it is applicable to a word mark which consists of the juxtaposition of a descriptive word combination and a letter sequence which is non-descriptive in itself, if the relevant public perceives that sequence as being an abbreviation of that word combination by reason of the fact that it reproduces the first letter of each word of that combination, and that the mark in question, considered as a whole, can thus be understood as a combination of descriptive indications or abbreviations which is therefore devoid of distinctive character.’ (Operative part).

ECJ 12 July 2012, C 311/11 P, Smart Technologies/OHIM

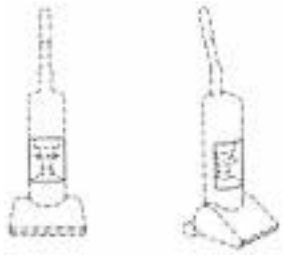
Wir machen das Besondere einfach

The slogan “Wir machen das Besondere einfach” lacks distinctive character in relation to computer software. “That the relevant public is a specialist one cannot have a decisive influence on the legal criteria used to assess the distinctive character of a sign. Although it is true that the degree of attention of the relevant specialist public is, by definition, higher than that of the average consumer, it does not necessarily follow that a weaker distinctive character of a sign is sufficient where the relevant public is specialist.’ (Para. 48).

ABSOLUTE GROUNDS
FOR REFUSAL
(SHAPES)



Vacuum cleaner manufacturer Dyson applied for registration of a trade mark that exists of 'a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner as shown in the representation'.



DYSON

(a characteristic is not a sign)

CJEU 25 January 2007, case C-321/03, Dyson/Registrar of Trade Marks

Article 2 Trade Mark Directive

The trademark application which relates, in a general and abstract manner, to an object with a variety of different appearances is no more than a characteristic of the product concerned and is not a sign in the meaning of a trade mark.

It follows that, to be capable of constituting a trade mark for the purposes of Article 2 of the Directive, the subject-matter of any application must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of being represented graphically. Thirdly, the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings. (Para. 28).

Although that provision mentions only signs which are capable of being perceived visually, are two-dimensional or three-dimensional and can thus be represented by means of letters or written characters or by a picture, it is however clear from the language of both Article 2 of the Directive and the seventh recital in the preamble thereto, which refers to a 'list of examples' of signs which may constitute a trade mark, that that list is not exhaustive. Accordingly, the Court has held previously that Article 2 of the Directive, although it does not mention signs which are not in themselves capable of being perceived visually, such as sounds or smells, does not expressly exclude them. (Para. 32).

However, if that condition is not to be deprived of all substance, it cannot be accepted that the subject matter of any trade mark application necessarily constitutes a sign within the meaning of Article 2 of the Directive. As the Court has held previously, the purpose of that requirement is in particular to prevent the abuse of trade mark law in order to obtain an unfair competitive advantage. (Para. 33, 34).

In the present case, it is common ground that the subject-matter of the application in the main proceedings is not a particular type of transparent collecting bin forming part of the external surface of a vacuum cleaner, but rather, in a general and abstract manner, all the conceivable shapes of such a collecting bin. (Para. 35).

Given the exclusivity inherent in trade mark right, the holder of a trade mark relating to such a nonspecific subject-matter would obtain an unfair competitive advantage, contrary to the purpose pursued by Article 2 of the Directive, since it would be entitled to prevent its competitors from marketing vacuum cleaners having any kind of transparent collecting bin on their external surface, irrespective of its shape. (Para. 38).

The subject-matter of the application at issue in the main proceedings is, in actual fact, a mere property of the product concerned and does not therefore constitute a 'sign' within the meaning of Article 2 of the Directive. (Para. 39).

Accordingly, the answer to be given to the national court must be that Article 2 of the Directive is to be interpreted as meaning that the subject-matter of an application for trade mark registration, such as that lodged in the main proceedings, which relates to all the conceivable shapes of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner, is not a 'sign' within the meaning of that provision and therefore is not capable of constituting a trade mark within the meaning thereof. (Para. 40).

Linde/Winward/Rado

(shape marks, public interest)

CJEU 8 April 2003, joined cases C-53/01 to C-55/01, Linde, Winward & Rado/DPMA

Article 3(1)(b)(c) Trade Mark Directive

When assessing distinctiveness no stricter test applies to shape marks (three-dimensional marks), but in view of the perception of the public it may be harder to prove distinctive character. The 'public interest' should be taken into account.



Linde, Winward and Rado sought registration with the German Trade Mark Office for the shape of a forklift truck, a flashlight and a watch respectively. They were all refused.

‘When assessing the distinctiveness of a three-dimensional shape of product trade mark for the purposes of Article 3(1)(b) [Trade Mark Directive] [...], a stricter test than that used for other types of trade mark must not be applied.’ (Operative part in 1).

By reason of the ‘perception’ of the public it can ‘in practice be more difficult to establish distinctiveness in relation to a shape of product mark than a word or figurative trade mark. But whilst that may explain why such a mark is refused registration, it does not mean that it cannot acquire distinctive character following the use that has been made of it and thus be registered as a trade mark under Article 3(3) of the Directive.’

‘Independently of Article 3(1)(e) [Trade Mark Directive], Article 3(1)(c) also has significance for three-dimensional shape of product trade marks.

When examining the ground for refusing registration in Article 3(1)(c) [Trade Mark Directive] in a concrete case, regard must be had to the public interest underlying that provision, which is that all three-dimensional shape of product trade marks which consist exclusively of signs or indications which may serve to designate the characteristics of the goods or service within the meaning of that provision should be freely available to all and, subject always to Article 3(3) of the Directive, cannot be registered.’ (Operative part in 2).

Henkel

(shape of packaging)



Henkel objected to the refusal by the German Trade Mark Office to register the shape mark reproduced above for liquid wool detergent.

CJEU 12 February 2004, case C-218/01, Henkel/DPMA; liquid wool detergent

Article 3(1)(b), (c) and (e) Trade Mark Directive

In case of goods that do not have a shape themselves, for instance liquids, the shape of the packaging of goods must be assimilated with the shape of the goods (within the meaning of Article 3(1)(e)). A mark which differs significantly from the norm of what is common in the industry in question, has distinctive character. The perception of the public of a shape mark is different from the perception of a word or figurative mark.

‘For three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the goods, the packing thereof must be assimilated to the shape of the goods, so that that packing may constitute the shape of the goods within the meaning of Article 3(1)(e) [Trade Mark Directive] and may, where appropriate, serve to designate characteristics of the packaged goods, including their quality, within the meaning of Article 3(1)(c) of that directive.’ (Operative part in 1).

‘In any event, the perception of the average consumer is not necessarily the same in the case of a three-dimensional trade mark, consisting of the packaging of a product, as it is in the case of a word or figurative mark which consists of a sign that is independent from the appearance of the goods it denotes. Average consumers are not in the habit of making assumptions about the origin of goods based on the shape of their packaging, in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctive character in the case of such a three-dimensional trade mark than in the case of a word or figurative mark.’ (Para. 52).

‘For three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the product, their distinctive character within the meaning of Article 3(1)(b) [Trade Mark Directive] must be assessed by reference to the perception of the average consumer of such goods, who is reasonably well informed and reasonably observant and circumspect. Such a trade mark must enable such a consumer to distinguish the product concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention.’ (Operative part in 2).

A simple derogation from the norm of what is common in the industry in question does not suffice to set aside the ground of refusal of Article 3(1)(b) of the Directive. On the contrary, a mark which differs significantly from the norm of what is common in the industry in question and thereby fulfils its essential function as origin indication, does have distinctive character.



Storck tried to obtain a Community trade mark registration for the shape of its Werther's Original sweets and its gold-coloured wrapper with twisted ends, reproduced above.

Werther's Original

(acquired distinctiveness of the shape of a sweet)

CJEU 22 June 2006, cases C-24/05 and C-25/05, Storck/OHIM; shape of a sweet

Article 7(1), (2) and (3) Trade Mark Regulation

*A three-dimensional mark may in certain circumstances acquire distinctive character through use even if it is used in conjunction with a word mark or a figurative mark. Evidence of acquired distinctive character in the part of the Community is required in which the sign did not, *ab initio*, have such character.*

Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) [Trade Mark Regulation]. 'Therefore, the Court of First Instance rightly took into consideration the shapes and colours of sweets commonly used in trade in assessing whether the mark applied for is, or is not, devoid of any distinctive character.' (Para. 27, case C-24/05).

'A three-dimensional mark may in certain circumstances acquire distinctive character through use even if it is used in conjunction with a word mark or a figurative mark. Such is the case where the mark consists of the shape of the product or its packaging and where they systematically bear a word mark under which they are marketed.' (Para. 59, case C-24/05).

'It follows that a mark can be registered under Article 7(3) [Trade Mark Regulation] only if evidence is provided that it has acquired, through the use which has been made of it, distinctive character in the part of the Community in which it did not, *ab initio*, have such character for the purposes of Article 7(1)(b). The part of the Community referred to in Article 7(2) may be comprised of a single Member State' (Para. 83, case C-25/05).

'Since, in paragraphs 85 to 87 of the judgment under appeal, following an assessment of the facts and evidence, the Court of First Instance found, first, that the mark applied for was devoid of any distinctive character, *ab initio*, in all of the Member States of the Community and, second, that the appellant did not establish that that mark was the subject of advertising campaigns in certain Member States during the reference period, it rightly found that the figures provided in relation to the advertising costs incurred by the appellant did not provide proof that the mark had acquired distinctive character as a result of the use which had been made of it.' (Para. 86, case C-25/05).

Philips/Remington

(technically dictated shape)



Philips objected to the sale by Remington of three-headed shaving devices on the basis of shape marks.

CJEU 18 June 2002, case C-299/99, Philips/Remington; three-headed shaver

Article 3(1)(e) Trade Mark Directive

A shape is unregistrable as a trade mark if its essential functional features are attributable only to a technical result. Such a shape can never acquire distinctive character by the use made of it.

‘In refusing registration of such signs, Article 3(1)(e), second indent, of the [Trade Mark Directive], reflects the legitimate aim of not allowing individuals to use registration of a mark in order to acquire or perpetuate exclusive rights relating to technical solutions.’ (Para. 82).

‘A sign which is refused registration under Article 3(1)(e) of the Directive can never acquire a distinctive character for the purposes of Article 3(3) by the use made of it.’ (Para. 75).

‘The rationale of the grounds for refusal of registration laid down in Article 3(1)(e) of the Directive is to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors. Article 3(1)(e) is thus intended to prevent the protection conferred by the trade mark right from being extended, beyond signs which serve to distinguish a product or service from those offered by competitors, so as to form an obstacle preventing competitors from freely offering for sale products incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark.’ (Para. 78).

‘Article 3(1)(e), second indent [Trade Mark Directive] must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable by virtue thereof if it is established that the essential functional features of that shape are attributable only to the technical result. Moreover, the ground for refusal or invalidity of registration imposed by that provision cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained.’ (Operative part in 4).

‘In order to be capable of distinguishing an article for the purposes of Article 2 of the Directive, the shape of the article in respect of which the sign is registered does not require any capricious addition, such as an embellishment which has no functional purpose.’ (Operative part in 2).



Benetton Group/ G-Star International

(substantial value)

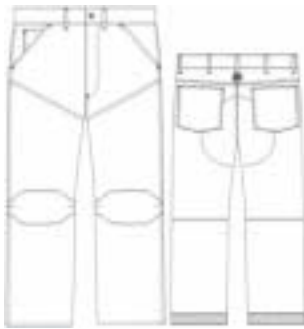
**CJEU 20 September 2007, case C-371/06, Benetton Group /
G-Star International; Elwood trousers**

Article 3(1)(e) and (3) Trade Mark Directive

The shape of a product which gives substantial value to that product, cannot constitute a trade mark, nor when it has acquired a distinctive character.

G-Star holds that the shape of the Elwood-trousers has become known as a mark through, inter alia, extensive advertising campaigns.

That the third indent of Article 3(1)(e) of the Directive is to be interpreted as meaning that the shape of a product which gives substantial value to that product cannot constitute a trade mark under Article 3(3) of that directive where, prior to the application for registration, it acquired attractiveness as a result of its recognition as a distinctive sign following advertising campaigns presenting the specific characteristics of the product in question. (Operative part).





The OHIM refused the application of the Lego-toy-brick as a figurative trade mark.

LEGO/OHIM

(technical solution)

CJEU 14 September 2010, case C-48/09 P, LEGO/OHIM

Article 7(1)(e) and (ii) Trade Mark Regulation

When the shape of a product merely incorporates a technical solution, it cannot be trade mark protected. The existence of functionally equivalent alternative shapes using the same technical solution is irrelevant. In the assessment (earlier) patents can be taken into account.

When the shape of a product merely incorporates the technical solution developed by the manufacturer of that product and patented by it, protection of that shape as a trade mark once the patent has expired would considerably and permanently reduce the opportunity for other undertakings to use that technical solution. In the system of intellectual property rights developed in the European Union, technical solutions are capable of protection only for a limited period, so that subsequently they may be freely used by all economic operators. (Para. 46).

The essential characteristics of the three-dimensional sign at issue be properly identified by the authority deciding on the application for registration of the sign as a trade mark. The expression 'essential characteristics' must be understood as referring to the most important elements of the sign. The identification of the essential characteristics of a three-dimensional sign may, depending on the case, and in particular in view of its degree of difficulty, be carried out by means of a simple visual analysis of the sign or, on the other hand, be based on a detailed examination in which relevant criteria of assessment are taken into account, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously in respect of the goods concerned. Once the sign's essential characteristics have been identified, the competent authority still has to ascertain whether they all perform the technical function of the goods at issue. (Para. 68-72).

The existence of other shapes which could achieve the same technical result is not such as to exclude the ground for refusal of registration. (See CJEU Philips/Remington). (Para. 83).

In examining the functionality of a sign consisting of the shape of goods, once the essential characteristics of the sign have been identified, it is only necessary to assess whether those characteristics perform the technical function of the product concerned. Clearly, that examination must be carried out by analyzing the sign filed with a view to its registration as a trade mark, and not signs consisting of other shapes of goods. The technical functionality of the characteristics of a shape may be assessed, inter alia, by taking account of the documents relating to previous patents describing the functional elements of the shape concerned. (Para. 84-85).



Freixenet Bottle

CJEU 14 September 2010, cases C 344/10 P and C 345/10, Freixenet/OHIM

Article 7(1)(b) Trade Mark Regulation

The shape of a bottle with certain characteristics, without a name or depiction, can be a trademark (provided it deviates significantly from the norm).

Freixenet had filed applications of the relevant pictures as CTM. In the applications, Freixenet stated that the marks for which registration was sought were in the category 'other' and consisted of the shape of presentation of a product. In one application Freixenet claimed the colour 'golden matt' and described the mark as a 'white polished bottle which when filled with sparkling wine takes on a golden matt appearance similar to a frosted bottle'. In the other application, Freixenet claimed the colour 'black matt' and described the mark as a 'frosted black matt bottle'. Furthermore, a declaration was annexed to those applications in which Freixenet stated that 'the applicant for the mark [did] not want to obtain restrictive and exclusive protection for the shape of the packaging but for the specific appearance of its surface'.

Instead of establishing whether the marks for which registration was sought varied significantly from the norm or customs of the sector, the General Court merely stated in a general manner, that since no bottle had been sold without a label or an equivalent, only that word element could determine the origin of the sparkling wine in question, so that the colour and matting of the glass of the bottle could not 'function as a trade mark' for sparkling wine for the relevant public when they were not used in combination with a word element. (Para. 50).

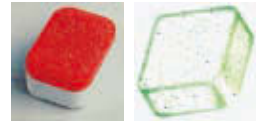
Such an assessment means that marks consisting of the appearance of the packaging of the product itself that do not contain an inscription or a word element would be excluded automatically from the protection that may be conferred by Regulation No 40/94. It follows that the General Court infringed Article 7(1)(b) of Regulation No 40/94. (Para. 51-52).

OTHER CASES CONCERNING SHAPE MARKS

Article 7(1)(b) Trade Mark Regulation



CJEU 29 April 2004, cases C-456/01 P, C-457/01 P and C-468/01 P t/m C-472/01 P, Henkel and P&G/OHIM; dishwasher tablets



The bicoloured dishwasher tablet of Henkel and the speckled dishwasher tablet of Procter & Gamble (see pictures) do not have any distinctive character.

CJEU 7 October 2004, case C-136/02 P, Maglite/OHIM; flashlight

The five registered Maglite flashlights lack any distinctive character. The fact that they can be considered to be 'high-quality design' does not automatically imply distinctive character.

CJEU 30 June 2005, C-286/04 P, Eurocermex/OHIM; Corona beer bottle

The shape of a bottle with a long neck in which a slice of lemon has been wedged and for which the colours yellow and green are claimed, does not have distinctive character for inter alia beer. (The CJEU does not give an opinion on the merits.)

CJEU 12 January 2006, C-173/04 P, SiSi/OHIM; standing pouches

The CJEU confirms the opinion of the Court of First Instance that such pouches 'were devoid of any distinctive character on the ground that that form of packaging is already in general use in the Community for liquids for human consumption and that, therefore, it is not sufficiently unusual for the average consumer to perceive it, per se, as an indication of the specific commercial origin of a product within that category.' (Para. 66)

Decisions by the Court of First Instance (CFI) in which the CFI held that there was sufficient distinctive character:

CJEU 24 May 2012, case C 98/11 P, Lindt & Sprüngli/OHIM

Three-dimensional sign consisting of the shape of a chocolate rabbit with a red ribbon.

The appellant failed to demonstrate that the mark has an inherently distinctive character and that this is the case for the entire territory of the European Union. For that reason, the Court of Justice cannot uphold the appellant's argument, and the statistics furnished in support of its argument, that the mark for which registration is sought has inherent distinctive character in 15 Member States and that, therefore, in those States, the acquisition by it of distinctive character through use does not have to be shown. (Para. 61).

Further, the appellant put forward 'that since the Community trade mark has a unitary character, the assessment of acquisition by a mark of distinctive character through use cannot be based on individual national markets, it should be noted that, even if it is true, that the acquisition by a mark of distinctive character through use must be proved for the part of the European Union in which that mark did not, ab initio, have such character, it would be unreasonable to require proof of such acquisition for each individual Member State.' (Para. 62).

However, as regards the present case, the General Court did not err in law because, in any event, the appellant has not sufficiently proved the acquisition, by the mark for which registration is sought, of distinctive character through use throughout the European Union. (Para. 63).



**CFI 5 March 2003, case T-128/01, DaimlerChrysler/OHIM;
Jeep-grille**

Sufficiently distinctive and not technically dictated:

‘The Court observes that the sign in question comprises a representation of the front part of a car having an irregular shape and with seven wide vertical openings in the centre and a circle representing the headlights of the vehicle on each side at the top. At the time when the application was filed, this shape was an unusual grille design, conveying the impression of an old-fashioned grille, in a simple configuration, which cannot be regarded as altogether commonplace in the circumstances at the time when the application was filed.

Consequently the sign in question cannot be regarded as the image that naturally comes to mind as the typical representation of a contemporary grille. OHIM’s finding that the sign in question is composed of features commonly used to represent a grille cannot therefore be upheld. In those circumstances the sign in question must be considered to be capable of leaving an impression on the memory of the target public as an indication of commercial origin and thus of distinguishing and setting apart motor vehicles bearing that grille from those of other undertakings.’ (Paras. 46-48).



**CFI 3 December 2003, case T-305/02, Nestlé/OHIM;
shape of a water bottle**

Truly specific and cannot be regarded as altogether commonplace:

‘The elements of presentation, which make up the mark applied for, is truly specific and cannot be regarded as altogether commonplace: ‘the nearly cylindrical main section of the bottle bears oblique grooves which, first, completely cover the bobbin-like part of the bottle and accentuate the curved, rounded effect of the bottle’s upper part and, second, are highlighted by the presence on the lower part of the bottle of grooves running in the opposite direction, the whole forming a design which is striking and easy to remember. That combination thus gives the bottle at issue a particular appearance which, taking account also of the overall aesthetic result, is capable of holding the attention of the public concerned and enabling that public, made aware of the shape of the packaging of the goods in question, to distinguish the goods covered by the registration application from those with a different commercial origin.’ (Para. 41).



**CFI 24 November 2004, case T-393/02, Henkel/OHIM;
shape of a white and transparent bottle**

A particular and unusual appearance:

The combination of visual aspects confers on the bottle in question ‘a particular and unusual appearance which is likely to attract the attention of the relevant public and enable that public, once familiar with the shape of the packaging of the goods in question, to distinguish the goods covered by the registration application from those having a different commercial origin.’ (Para. 40).

Libertel

(colour marks, general interest)

CJEU 6 May 2003, case C-104/01, Libertel/BMB; colour orange

Articles 2 and 3 Trade Mark Directive



Libertel filed a colour mark application for the colour orange (PMS 144) for (mobile) telecommunication services.

A colour per se can be a mark, but this usually requires acquired distinctiveness. Regard must be had to the 'general interest' in not unduly restricting the availability of colours. For registration of a colour mark reproduction on paper and/or description of the colour is not sufficient, an internationally recognised colour code is required.

'A colour per se, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of Article 3(1)(b) and Article 3(3) [Trade Mark Directive] [...], provided that, inter alia, it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The latter condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognised identification code.' (Operative part in 1).

'In assessing the potential distinctiveness of a given colour as a trade mark, regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought.' (Operative part in 2).

'A colour per se may be found to possess distinctive character within the meaning of Article 3(1)(b) and Article 3(3) [Trade Mark Directive], provided that, as regards the perception of the relevant public, the mark is capable of identifying the product or service for which registration is sought as originating from a particular undertaking and distinguishing that product or service from those of other undertakings.' (Operative part in 3).

As a rule acquired distinctiveness is required.

'In the case of a colour per se, distinctiveness without any prior use is inconceivable save in exceptional circumstances, and particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific.' (Para. 66).



Heidelberger Bauchemie

(colour combinations)

CJEU 24 June 2004, case C-49/02, Heidelberger Bauchemie; blue and yellow

Articles 2 and 3 Trade Mark Directive

A colour combination may be a mark, but registration requires (next to a colour example, a description and an internationally recognised colour code) a 'systematic arrangement'.

Heidelberger Bauchemie filed a colour mark application for the combination of blue and yellow (trade mark reproduction: a rectangular piece of paper, the top half of which is blue and the bottom half is yellow) provided with colour codes and a description: 'The applied for mark consists of the company colours of the applicant which are used in all conceivable forms, in particular for packaging and labels.'

'The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', as is the case with the trade mark which is the subject of the main proceedings, does not exhibit the qualities of precision and uniformity required by Article 2 of the Directive, as construed in paragraphs 25 to 32 of this judgment. 35 Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark.' (Paras. 34-35).

'Colours or combinations of colours which are the subject of an application for registration as a trade mark, claimed in the abstract, without contours, and in shades which are named in words by reference to a colour sample and specified according to an internationally recognised colour classification system may constitute a trade mark for the purposes of Article 2 [Trade Mark Directive] where:

- it has been established that, in the context in which they are used, those colours or combinations of colours in fact represent a sign, and
- the application for registration includes a systematic arrangement associating the colours concerned in a predetermined and uniform way.' (Operative part in 1).

'Even if a combination of colours satisfies the requirements for constituting a trade mark for the purposes of Article 2 of the Directive, it is still necessary for the competent authority for registering trade marks to decide whether the combination claimed fulfils the other requirements laid down, particularly in Article 3 of the Directive, for registration as a trade mark in relation to the goods or services of the undertaking which has applied for its registration. Such an examination must take account of all the relevant circumstances of the case, including any use which has been made of the sign in respect of which trade mark registration is sought. That examination must also take account of the public interest in not unduly restricting the availability of colours for other traders who market goods or services of the same type as those in respect of which registration is sought.' (Operative part in 2).

Sieckmann

(smell marks)

CJEU 12 December 2002, case C-273/00, Sieckmann/DPM; smell mark

Article 2 Trade Mark Directive

A sign which is not in itself capable of being perceived visually, can be registered as a trade mark, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. This is (probably) not (yet) possible for smells.

Sieckmann filed a smell mark application consisting of the chemically pure substance methyl cinnamate (cinnamon acid methyl ester), chemical formula: $C_6H_5-CH = CHCOOCH_3$, with a container with an odour sample and the statement that the colour is usually described as balm-like fruity with a hint of cinnamon.

From the perspective of register clarity due graphical representation is required.

‘Article 2 [Trade Mark Directive] [...] must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.’ (Operative part in 1).

‘Few people would recognise in such a formula the odour in question. Such a formula is not sufficiently intelligible. In addition, [...], a chemical formula does not represent the odour of a substance, but the substance as such, and nor is it sufficiently clear and precise. It is therefore not a representation for the purposes of Article 2 of the Directive. In respect of the description of an odour, although it is graphic, it is not sufficiently clear, precise and objective. As to the deposit of an odour sample, it does not constitute a graphic representation for the purposes of Article 2 of the Directive. Moreover, an odour sample is not sufficiently stable or durable.’ (Paras. 69-71).

‘In respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements.’ (Operative part in 2).

Shield Mark

(sound marks)

**CJEU 27 November 2003, case C-283/01, Shield Mark/BMB;
sound marks**

Article 2 Trade Mark Directive



A musical staff meets the requirement of graphical representation of a sound mark, a description or an onomatopoeia does not.

Shield Mark filed several sound mark applications for the first nine notes of Für Elise of Ludwig von Beethoven and for a cockcrow.

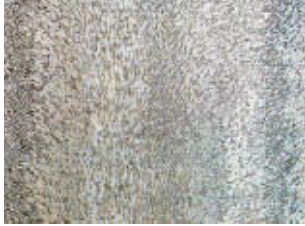
‘Article 2 [Trade Mark Directive] is to be interpreted as meaning that sound signs must be capable of being regarded as trade marks provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically.

Article 2 [Trade Mark Directive] must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

In the case of a sound sign, those requirements are not satisfied when the sign is represented graphically by means of a description using the written language, such as an indication that the sign consists of the notes going to make up a musical work, or the indication that it is the cry of an animal, or by means of a simple onomatopoeia, without more, or by means of a sequence of musical notes, without more.

On the other hand, those requirements are satisfied where the sign is represented by a staff divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.’ (Operative part).

OTHER CASES ON REFUSAL ON ABSOLUTE GROUNDS



CJEU 28 June 2004, case C-445/02, Glaverbel/OHIM; surface of glass

Articles 2 and 3 Trade Mark Directive

Glaverbel filed an application for registration as a Community trade mark of a sign described as ‘a design applied to the surface of the goods’ in respect of sanitary installations.

The Court held that: ‘the design, which consists of countless tiny strokes applied to the surface of the sheet, no matter what its area, forms part of the appearance of the product itself and embodies obvious characteristics of the product, with the result that it is perceived primarily as a technical means of rendering the glass opaque. Moreover, it stated that the complexity and fancifulness of the design in respect of which registration was sought is attributable rather to the ornamental and decorative nature of the design’s finish. The overall complexity of the design and the fact that it is applied to the external surface of the product do not allow the design’s individual details to be committed to memory or the design to be apprehended without the product’s inherent qualities being perceived simultaneously. Finally, it took the view that the impression conveyed by the sign is not fixed and varies according to the angle from which the goods are viewed, the brightness of the light and the quality of the glass. (Para. 33).

CJEU 21 October 2004, case C-447/02, KWS/Saat/OHIM; colour orange

The colour orange (HKS7) is not rare for treatment installations for seeds and for agricultural, horticultural and forestry products.

CJEU 7 July 2005, case C-418/02, Praktiker Märkte/DPMA; retail trade services

A mark can be registered for ‘retail trade services’.

The German Trade Mark Office refused to register the mark Praktiker as mark for ‘retail trade in building, home improvement and gardening goods for the do-it-yourself sector’.

‘The concept of ‘services’ referred to by [the Trade Mark Directive], in particular in Article 2, covers services provided in connection with retail trade in goods. For the purposes of registration of a trade mark for such services, it is not necessary to specify in detail the service(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate.’ (Operative part).

**CJEU 30 March 2006, case C-259/04, Elizabeth Emanuel/
Continental Shelf 128; Elizabeth Emanuel**

Registration of a mark (Elizabeth Emanuel) which is identical to the name of the designer and first producer of, in this case, clothing on which this mark has been affixed 'may not, by reason of that particular feature alone, be refused registration on the ground that it would deceive the public, within the meaning of Article 3(1)(g) [Trade Mark Directive] [...], in particular where the goodwill associated with that trade mark, previously registered in a different graphic form, has been assigned together with the business making the goods to which the mark relates.

A trade mark corresponding to the name of the designer and first manufacturer of the goods bearing that mark is not, by reason of that particular feature alone, liable to revocation on the ground that that mark would mislead the public, within the meaning of Article 12(2)(b) [Trade Mark Directive], in particular where the goodwill associated with that mark has been assigned together with the business making the goods to which the mark relates.'(Operative part).

**CJEU 5 July 2011, C-263/09 P, Edwin Co. Ltd/
OHIM & Elio Fiorucci**

Article 50(1)(c) and article 52(2) Trade Mark Regulation.

Italian Elio Fiorucci challenges, on the basis of his own (well known) name, the registration 'Elio Fiorucci' by Edwin. His objection is made on the ground that it is misleading and conflicts with the right to his name.

The application of Article 52(2) of Regulation No 40/94 is not restricted 'merely to situations where the registration of a Community trade mark conflicts with a right intended exclusively to protect a name as an attribute of the personality of the person concerned.' (Para. 36).

**CJEU 19 June 2012, case C-307/10, The Chartered Institute of
Patent Attorneys/Registrar of Trade Marks; IP Translator**

The Trade Mark Directive 'must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark.'

The Trade Mark Directive 'must be interpreted as meaning that it does not preclude the use of the general indications of the class headings of the Classification referred to in Article 1 of the Nice Agreement [...] to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise.'

‘An applicant for a national trade mark who uses all the general indications of a particular class heading of the Classification referred to in Article 1 of the Nice Agreement to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of that class or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.’ (Operative part).

Arthur & Félicie

(sign identical to mark)

**CJEU 20 March 2003, case C-291/00, LTJ Diffusion/Sadas;
Arthur (& Félicie)**

Article 5(1)(a) Trade Mark Directive



A sign is identical to a trade mark if it represents all elements of that trade mark without any change or addition.

LTJ Diffusion objected on the basis of its word and figurative mark Arthur for inter alia clothing to the use of the mark Arthur & Félicie by Sadas, also for clothing.

Compare: CFI 24 November 2005, case T-346/04:
Arthur & Félicie does infringe earlier mark Arthur under '(b)'.

'Article 5(1)(a) [Trade Mark Directive] [...] must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.' (Operative part).

'The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is guaranteed by Article 5(1)(a) of the directive, cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by Article 5(1)(b) of the directive. (Para. 5.)

There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter. (Para. 51).

However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question.' (Para. 52).



Adam Opel/Autec

(scale model)

CJEU 25 January 2007, case C-48/05, Adam Opel/Autec

Article 5(1)(c) and (2); article 6(1)(b) Trade Mark Directive

The use of a trade mark for scale models is no trademark use.

Car manufacturer Opel obtains objection against the use of the Opel-logo on scale models.

Where a trade mark is registered both for motor vehicles – in respect of which it is well known – and for toys, the affixing by a third party, without authorization from the trade mark proprietor, of a sign identical to that trade mark on scale models of vehicles bearing that trade mark, in order faithfully to reproduce those vehicles, and the marketing of those scale models:

- constitute, for the purposes of Article 5(1)(a) of the [Trade Mark Directive], a use which the proprietor of the trade mark is entitled to prevent if that use affects or is liable to affect the functions of the trade mark as a trade mark registered for toys;
- constitute, within the meaning of Article 5(2) of that directive, a use which the proprietor of the trade mark is entitled to prevent – where the protection defined in that provision has been introduced into national law – if, without due cause, use of that sign takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark as a trade mark registered for motor vehicles. (Operative part in 1).



Where a trade mark is registered, inter alia, in respect of motor vehicles, the affixing by a third party, without the authorization of the proprietor of the trade mark, of a sign identical to that mark to scale models of that make of vehicle, in order faithfully to reproduce those vehicles, and the marketing of those scale models, do not constitute use of an indication concerning a characteristic of those scale models, within the meaning of Article 6(1)(b) of Directive 89/104. (Operative part in 2).



Puma/Sabel

(confusion and association)

CJEU 11 November 1997, case C-251/95, Puma/Sabel; bounding feline

Article 4 and 5(1)(b) Trade Mark Directive



The only relevant criterion in art. 4 and 5(1)(b) Trade Mark Directive is likelihood of confusion. The addition 'which includes likelihood of association' has little significance.

Puma objected on the basis of its figurative mark representing a puma to the trade mark registration of Sabel of a 'bounding feline', for inter alia leather goods.

“The criterion of ‘likelihood of confusion which includes the likelihood of association with the earlier mark’ contained in Article 4(1)(b) [Trade Mark Directive] [...] is to be interpreted as meaning that the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion within the meaning of that provision.’ (Operative part).

“The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

[...]the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

[...]the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.

However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion. ‘(Paras. 22-25).

Canon/Cannon

(similarity and reputation)

**CJEU 29 September 1998, case C-39/97, Canon/
Metro-Goldwyn-Mayer; Canon/Cannon**

Article 4 and 5(1)(b) Trade Mark Directive

Similarity of goods also depends on the reputation of the earlier mark.

Canon objected to the trade mark registration by Metro-Goldwyn-Mayer of the word mark Cannon for inter alia video tape cassettes.

‘On a proper construction of Article 4(1)(b) [Trade Mark Directive] [...], the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.’ (Operative part).

‘A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.’ (Para. 17).

‘There may be a likelihood of confusion within the meaning of Article 4(1)(b) [Trade Mark Directive] even where the public perception is that the goods or services have different places of production. By contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings.’ (Operative part).

Lloyd/Loint's

(confusion and aural similarity)

CJEU 22 June 1999, case C-342/97, Lloyd/Klijzen; Lloyd/Loint's
Article 5(1)(b) Trade Mark Directive

Likelihood of confusion by the average consumer is to be assessed globally, but mere aural similarity may suffice to assume likelihood of confusion. 'For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect.'

Lloyd Schuhfabrik objected on the basis of its word mark Lloyd, for shoes, to the registration by Klijzen of the word mark Loint's, also for shoes.

'It is possible that mere aural similarity between trade marks may create a likelihood of confusion within the meaning of Article 5(1)(b) [Trade Mark Directive] [...]. The more similar the goods or services covered and the more distinctive the earlier mark, the greater will be the likelihood of confusion. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make a global assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings.' (Operative part).

'For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 Gut Springenheide and Tusky [1998] ECR I -4657, paragraph 31). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.' (Para. 26).

'In making that assessment, account should be taken of all relevant factors and, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered. It is not possible to state in general terms, for example by referring to given percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has a strong distinctive character.' (Operative part).

Picasso/Picaro

(likelihood of confusion)

**CJEU 12 January 2006, case C-361/04, The Picasso estate/
DaimlerChrysler; Picasso/Picaro**

Article 8(1)(b) Trade Mark Regulation



Visual and phonetic similarity may be counteracted by an explicit conceptual difference.

The Picasso heirs objected on the basis of the word mark Picasso for inter alia cars to the registration of the word mark Picaro by DaimlerChrysler, also for cars.

The marks Picasso and Picaro are visually and phonetically similar. From the conceptual point of view, the word Picasso is particularly well known to the relevant public as being the name of the famous painter Pablo Picasso. The word Picaro may be understood by Spanish-speaking persons as referring inter alia to a character in Spanish literature, whereas it has no semantic content for the (majority) non-Spanish-speaking section of the relevant public.

Such conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately.' (Para. 55- 56).

'Where it is established in fact that the objective characteristics of a given product mean that the average consumer purchases it only after a particularly careful examination, it is important in law to take into account that such a fact may reduce the likelihood of confusion between marks relating to such goods at the crucial moment when the choice between those goods and marks is made.' (Para. 40).

'In doing so, the Court did not in any way express a general rule from which it could be inferred that, for the purposes of an assessment of the likelihood of confusion within the meaning of Article 5(1)(b) [Trade Mark Directive] or Article 8(1)(b) [Trade Mark Regulation], there is no need to refer specifically to the particularly high level of attention displayed by consumers when purchasing a certain category of goods.' (Para. 47).

Obelix/Mobilix

(confusion and aural similarity)

CJEU 18 December 2008, case C-16/06 P, Les Éditions Albert René/Orange A/S; OBELIX/MOBILIX

Article 8 and 63 Trade Mark Directive

The fact that the word mark 'OBELIX', from the point of view of the relevant public, has a clear and specific meaning, so that the public is capable of grasping it immediately, implies that conceptual differences between two signs may counteract aural and visual similarities between them.

Strip publisher and proprietor of the trade mark Obelix, Les Éditions Albert René, objects to the registration of the trade mark Mobilix.

The Court has stated, in a factual assessment, that the 'OBELIX' sign conveys a reference to a famous character from a comic strip and, as a result, is conceptually different from the 'MOBELIX' sign; it did not thus rule on the well known nature of the OBELIX trade mark. (Para. 96).

Case-law shows that the global assessment of the likelihood of confusion implies that conceptual differences between two signs may counteract aural and visual similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately. (Para. 98).

As regards the appellant's argument derived from the fact that it is the proprietor of a family of marks characterised by the '-ix' suffix, the Court notes that, although the appellant has invoked a number of earlier marks which, it submits, are part of that family, it based its opposition solely on the earlier mark OBELIX. (Para. 100).

Il Ponte Finanziaria/ F.M.G. Textiles

(series of trade marks)

CJEU 13 September 2007, case C-234/06, Il Ponte Finanziaria/ F.M.G. Textiles

Article 8(1)(b) Trade Mark Directive

Series of trade marks must be present on the market to be of influence as to risk of confusion. 'Defensive trademarks' are not compatible with the Community trade mark system.

Opposition by the proprietor of earlier national trade marks all having the component 'Bridge' in common.

No consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for be-longs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market. (Para. 64).

In any event, while it is possible, to consider a registered trade mark as used where proof is provided of use of that mark in a slightly different form from that in which it was registered, it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trade mark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former. (Para. 86).

A proprietor of a national registration who opposes a Community trade mark application cannot, in order to avoid the burden of proof which rests upon him, rely on a national provision which allows the registration, as trade marks, of signs not intended to be used in trade on account of their purely defensive function in relation to another sign which is being commercially exploited. (Para. 101).

The concept of 'proper reasons' mentioned in that article refers essentially to circumstances unconnected with the proprietor of a trade mark which prevent him from using the mark, rather than to national legislation which makes an exception to the rule that a trade mark that has not been used for a period of five years must be revoked, even where such lack of use is intentional on the part of the proprietor of the trade mark. (Para. 102).

The argument that the holder of a national registration who opposes a Community trade mark application can rely on an earlier trade mark the use of which has not been established on the ground that, under national legislation, that earlier mark constitutes a 'defensive trade mark' is therefore incompatible with Article 43(2) and (3) of Regulation No 40/94. (Para. 103).



OHIM/Shaker; Limoncello

CJEU 12 June 2007, case C-334/05 P, OHIM/Shaker; Limoncello

Article 8(1)(b) Trade Mark Regulation

Various dominant components of the graphic element do not preclude the likelihood of confusion between the word- and figurative mark and an earlier trade mark.

The proprietor of the earlier Spanish word mark 'Limonchelo' objects to the registration of the word- and figurative mark of the word limoncello and a sign consisting a round dish decorated with lemons on a blue background.

According to settled case-law, the global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyze its various details. (Para. 35).

It should be added that in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to assess the importance to be attached to those various factors, taking account of the category of goods or services in question and the circumstances in which they are marketed. (Para. 36).

However, the Court stated in the judgment under appeal that, if the trade mark claimed was a complex mark which was visual in nature, the assessment of the overall impression created by that mark and the determination as to whether there was a dominant element had to be carried out on the basis of a visual analysis. It added that, in such a case, it was only to the extent to which a potentially dominant element included non-visual semantic aspects that it might become necessary to compare that element with the earlier mark, also taking into account those other semantic aspects, such as for example phonetic factors or relevant abstract concepts. (Para. 38).

On the basis of those considerations, the Court of First Instance, in the context of the analysis of the signs at issue, firstly held that the mark for which registration was sought contained a dominant element comprising the representation of a round dish decorated with lemons. It then inferred that it was not necessary to examine the phonetic or conceptual features of the other elements of that mark. It finally concluded that the dominance of the figurative representation of a round dish decorated with lemons in comparison with the other components of the mark prevented any likelihood of confusion arising from the visual, phonetic or conceptual similarities between the words 'limonchelo' and 'limoncello' which appear in the marks at issue. (Para. 39).

According to the case law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components. (Para. 41).

Carbonell/La Española

(likelihood of confusion of figurative trademarks)



CJEU 3 September 2009, case C-498/07 P, Aceites del Sur/Koipe; Carbobell/La Española

Article 8(1)(b) Trade Mark Regulation

For figurative trademarks the visual element can be very dominant and if there is similarity this can cause confusion, despite differing word elements.

Aceites del Sur is proprietor of a figurative trademark of an olive oil label and objects to the registration by Koipe of the figurative trademark of another olive oil label (see pictures).

The Court of First Instance thus attributed to the figurative element of the marks at issue the character of a dominant element in relation to the other elements comprising those marks, in particular the word element. That enabled it correctly to base its assessment on the similarity of the signs and on the existence of a likelihood of confusion between the marks La Española and Carbonell by giving the visual comparison of those signs an essential character. (Para. 66).

Thus, having made a detailed comparative assessment of the marks at issue from a visual point of view, the Court then held that the elements common to the two marks, seen as a whole, produced an overall visual impression of great similarity, since the La Española mark reproduced very precisely the essence of the message and the visual impression given by the Carbonell mark, thus inescapably giving rise to a likelihood of confusion on the part of the consumer between those marks. (Para. 68).

The Court of First Instance lastly held that such a likelihood of confusion is not diminished by the existence of the different word element, in view of the latter's very weak distinctive character in relation to the mark in respect of which registration was sought, which refers to the geographical origin of the goods. (Para. 69).

Whilst considering the figurative element of those marks as a dominant element in relation to the other elements of which they are comprised, the Court of First Instance did not fail to take the word element into account. On the contrary, it is precisely in the context of the assessment of that element that the Court of First Instance described it essentially as negligible, on the ground, in particular, that the differences between the word signs of the marks at issue do not invalidate the conclusion it reached after the comparative examination of those marks from the visual point of view. (Para 70).

The Court of First Instance correctly applied the rule that a global assessment should be undertaken when determining whether a likelihood of confusion exists between the marks at issue. (Para. 71).

Ferrero/OHIM; Kinder

(similarity)

CJEU 24 March 2011, case C-552/09 P, Ferrero/OHIM; Kinder

Article 8(1)(b) and (5) Trade Mark Directive



Without any similarity between the marks, the likelihood of confusion needs not to be assessed.

Ferrero filed a notice of opposition to the registration of the trade mark “TiMi KiNDERJOGHURT” filed by Tirol Milch, based on its earlier word mark KINDER.

The Court has judged that the fact that the word ‘kinder’ is present in both of the signs at issue, there were a number of visual and phonetic features which precluded the signs from being perceived as similar. (Para. 26).

In order for Article 8(1)(b) or (5) of [Trade Mark Regulation] to be applicable, the marks at issue must be identical or similar. Consequently, those provisions are manifestly inapplicable where the General Court has ruled out any similarity between the marks at issue. It is only if there is some similarity, even faint, between the marks at issue that the General Court must carry out a global assessment in order to ascertain whether, notwithstanding the low degree of similarity between them, there is, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, a likelihood of confusion or a link made between those marks by the relevant public. (Para. 66).

The existence of a ‘family’ or a ‘series’ of trademarks is an element which must be taken into account for the purposes of assessing the likelihood of confusion. In those circumstances, the likelihood of confusion results from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for and may consider, erroneously, that that trade mark is part of that family or series of marks (see *Il Ponte Finanziaria/OHIM*). (Para. 97).

In so far as the General Court found, in the judgment under appeal, that a certain number of visual and phonetic features of the signs at issue precluded them from being perceived as similar, it could, without erring in law, that that finding is not called into question by the existence of a ‘family’ or ‘series’ of trademarks. (Para. 100).

Calvin Klein



CJEU 2 September 2010, case C-254/09 P, Calvin Klein Trademark Trust/OHIM

Article 8(1)(b) and (5) Trade Mark Regulation 40/94

Wrongful conduct is not a factor for the assessment of similarity in opposition proceedings.

Based on its CK figurative trade marks, Calvin Klein objects to the trade mark application of CK CREACIONES KENNYA



The General Court found that the overall impression created by the mark applied for is dominated by the element 'creaciones kenny', on which the consumer concerned will to a very great extent focus his attention and, second, that the element 'ck' occupies only an ancillary position in relation to that element, which, in essence, amounts to a conclusion that the element 'ck' in the mark applied for is negligible. (Para. 57).

Thus, having ruled out, on the basis of a properly conducted analysis, any similarity between the marks at issue, the General Court correctly concluded, at paragraphs 53 to 57 of the judgment under appeal, that, notwithstanding the reputation of the earlier marks and the fact that the goods covered by the marks at issue are identical, there is no likelihood of confusion between the marks. (Para. 58).

It should be noted in that connection that the similarity of the marks at issue must be assessed from the point of view of the average consumer by referring to the intrinsic qualities of the marks and not to circumstances relating to the conduct of the person applying for a Community trade mark. (Para. 46).

It must therefore be held that, contrary to the appellant's submissions in the first part of its first ground of appeal, the General Court's analysis is not vitiated by an error of law due to the fact that it failed to take account of alleged wrongful conduct on the part of the trade mark applicant. While such conduct is a particularly significant factor in proceedings brought under Article 51(1)(b) [in the meantime article 52(1)(b)] of [the Trade Marks Regulation]– which is not at issue in the present appeal – it is not, on the other hand, a factor that must be taken into account in opposition proceedings brought under Article 8 of that regulation. (Para. 47).



Adidas/Marca II

(infringementquestion)

CJEU 10 April 2008, case C-102/07, Adidas/Marca II

Article 5(1)(b) and 6 Trade Mark Directive

In the assessment of infringement the requirement of availability cannot be taken into account except for the situation dealt with in article 6 Directive.

Adidas objects to the use of two stripes, Marca en H&M invoked on the requirement of availability in relation to the use of two stripes.



The public's perception that a sign is a decoration cannot constitute a restriction on the protection conferred by Article 5(1)(b) of the Directive when, despite its decorative nature, that sign is so similar to the registered trade mark that the relevant public is likely to perceive that the goods come from the same undertaking or, as the case may be, from economically-linked undertakings. (Para. 34).

In the present case, it must therefore be determined whether the average consumer, when he sees sports or leisure garments featuring stripe motifs in the same places and with the same characteristics as the stripes logo registered by Adidas, except for the fact that they consist of two rather than three stripes, may be mistaken as to the origin of those goods, believing that they are marketed by Adidas or an undertaking linked economically to those undertakings. (Para. 35).

As is clear from the 10th recital in the Directive, that appreciation depends not solely on the degree of similarity between the trade mark and the sign, but also on the ease with which the sign may be associated with the mark having regard, in particular, to the recognition of the latter on the market. The more the mark is well known, the greater the number of operators who will want to use similar signs. The presence on the market of a large quantity of goods covered by similar signs might adversely affect the trade mark in so far as it could reduce the distinctive character of the mark and jeopardise its essential function, which is to ensure that consumers know where the goods concerned come from. (Para. 36).

The requirement of availability cannot be taken into account in the assessment of the scope of the exclusive rights of the proprietor of a trade mark, except in so far as the limitation of the effects of the trade mark defined in Article 6(1)(b) of the Directive applies.

[The Trade Mark Directive] must be interpreted as meaning that the requirement of availability cannot be taken into account in the assessment of the scope of the exclusive rights of the proprietor of a trade mark, except in so far as the limitation of the effects of the trade mark defined in Article 6(1)(b) of the Directive applies. (Operative Part).

Céline

(the use of a trade name as a trade mark)

CJEU 11 September 2007, case C-17/06, Céline SARL/Céline SA

Article 5(1)(a) and 6 (1)(a) Trade Mark Directive

Use of a company name, trade name or shop name which is identical to an earlier mark in connection with the marketing of goods which are identical to those in relation to which that mark was registered, constitutes use which the proprietor of that mark is entitled to prevent in accordance with Article 5(1)(a) of the directive, where the use is in relation to goods in such a way as to affect or be liable to affect the functions of the mark.

The earlier French trade mark Céline (filed in 1948) objects to the use of the younger/earlier company name/trade name/shop name Céline (1950).

The purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being 'in relation to goods or services' within the meaning of Article 5(1) of the directive. (Para. 21).

Conversely, there is use 'in relation to goods' within the meaning of Article 5(1) of the directive where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets. (Para. 22).

In addition, even where the sign is not affixed, there is use 'in relation to goods or services' within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party. (Para. 23).

The unauthorized use by a third party of a sign which is identical to a registered mark in relation to goods or services which are identical to those for which that mark is registered cannot be prevented under Article 5(1)(a) of the directive unless it affects or is liable to affect the functions of the mark, in particular its essential function of guaranteeing to consumers the origin of the goods or services. (Para. 26).

That is the situation where the sign is used by the third party in relation to his goods or services in such a way that consumers are liable to interpret it as designating the origin of the goods or services in question. In such a case, the use of the sign is liable to imperil the essential function of the mark, since, for the trade mark to be able to fulfill its essential role in the system of un-distorted competition which the EC Treaty seeks to establish and maintain, it must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality. (Para. 27).

In the light of all of the above considerations, the answer to the question referred must be that the unauthorized use by a third party of a company name, trade name or shop name which is identical to an earlier mark in connection with the marketing of goods which are identical to those in relation to which that mark was registered constitutes use which the proprietor of that mark is entitled to prevent in accordance with Article 5(1)(a) of the directive, where the use is in relation to goods in such a way as to affect or be liable to affect the functions of the mark.

Should that be the case, Article 6(1)(a) of the directive can operate as a bar to such use being prevented only if the use by the third party of his company name or trade name is in accordance with honest practices in industrial or commercial matters. (Para. 36).

Montex/Diesel

(transit)

CJEU 9 November 2006, case C-281/05, Montex/Diesel

Article 5(1) and (3) Trade Mark Directive

The mere risk that goods will not reach their destination, a Member State where is no form of protection for the trade mark Diesel, and that the goods theoretically can unlawfully enter the market in the Member State of transit, does not imply that the transit affects the substantial functions of the trade mark in the Member State of transit.

Montex manufactures jeans in Poland [at the time not a Member State of the European Union] and returns the jeans to Ireland via Germany.

Article 5(1) and (3) of [the Trade Mark Directive] is to be interpreted as meaning that the proprietor of a trade mark can prohibit the transit through a Member State in which that mark is protected (the Federal Republic of Germany in the present case) of goods bearing the trade mark and placed under the external transit procedure, whose destination is another Member State where the mark is not so protected (Ireland in the present case), only if those goods are subject to the act of a third party while they are placed under the external transit procedure which necessarily entails their being put on the market in that Member State of transit. (Operative part in 1).

It is in that regard, in principle, irrelevant whether goods whose destination is a Member State come from an associated State or a third country, or whether those goods have been manufactured in the country of origin lawfully or in infringement of the existing trade mark rights of the proprietor in that country. (Operative part in 2).

OTHER CASES CONCERNING CONFUSION

Article 8(1)(b) Trade Mark Regulation
Article 5(1)(b) Trade Mark Directive

See also: CJEU 23 October 2003, case C-408/01, Adidas/Fitnessworld Trading.



See also: CJEU 9 March 2006, C-421/04, Matratzen Concord/Hukla.



CJEU 22 June 2000, case C-425/98, Marca/Adidas; three versus two stripes

Marca sold clothing with two stripes, Adidas objected to this on the basis of its well-known three-stripe mark.

‘Article 5(1)(b) [Trade Mark Directive] [...] cannot be interpreted as meaning that where:

- a trade mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public, and
- a third party, without the consent of the proprietor of the mark, uses, in the course of trade in goods or services which are identical with, or similar to, those for which the trade mark is registered, a sign which so closely corresponds to the mark as to give rise to the possibility of its being associated with that mark,

the exclusive right enjoyed by the proprietor entitles him to prevent the use of the sign by that third party if the distinctive character of the mark is such that the possibility of such association giving rise to confusion cannot be ruled out.’ (Operative part).

‘The Court [in Puma/Sabel] did not excuse the national court from the necessary positive finding of the existence of a likelihood of confusion which constitutes the matter to be proved.’ (Para. 39).

CJEU 28 April 2004, case C-3/03 P, Matratzen Concord/OHIM-Hukla; Matratzen

Hukla opposed the registration of a word and visual mark as a Community trade mark (see picture) for mattresses by Matratzen Concord on the basis of its Spanish word mark ‘Matratzen’. (‘Matratzen’ is the German word for mattresses, but it is unknown in Spanish).

The Court of First Instance concluded that the word ‘Matratzen’ was the dominant element of the trade mark applied for. It therefore held that, from the point of view of the relevant (Spanish) public, there existed a visual and aural similarity between the two trade marks. Finally, the Court held that, ‘considered cumulatively, the degree of similarity between the trade marks in question and the degree of similarity between the goods covered by them was sufficiently high and that the Board of Appeal was therefore entitled to hold that there was a likelihood of confusion between the trade marks in question. ‘The Court rightly pointed out, [...], that the assessment of the similarity between two marks does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. It also held that that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.’ (Para 32).

CJEU 12 October 2004, case C-106/03 P, Verdial/OHIM; Saint-Hubert 41/Hubert

Word and figurative mark Hubert (see picture) is insufficiently similar to the earlier French word mark ‘Saint-Hubert 41’ to assume likelihood ‘whatever the reputation of the earlier mark and regardless of the degree of identity or similarity of the goods or services concerned.’ (Para. 54)

CJEU 6 October 2005, case C-120/04, Medion/ Thomson; Life/Thomson Life

Earlier mark 'Life' versus later mark 'Thomson Life'. Rejection of so-called German 'Präge theory'. (According to this theory upon comparison of overall impressions the most 'geprägte' ('impressive') element, i.e. 'Thomson', would mainly put the 'only co-defining' element 'Life' in the background).

There may be confusion amongst the public between identical goods and services 'where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.'



CJEU 1 December 2005, case C-512/04 P, Vitakraft/ OHIM-Krafft; Krafft/Vitakraft

The Spanish company Krafft opposes the registration of the word mark 'Vitakraft' on the basis of its Spanish word and figurative marks containing the word 'Krafft' (see pictures).

According to the Court of First Instance there is a risk of confusion, because to a Spanish audience the element 'Kraft' is the most distinctive part, because this word does not have a meaning in Spanish. This is an assessment of the facts which is not for the CJEU to decide.

CJEU 23 March 2006, case C-206/04 P, Mülhens/OHIM en Zirh; Sir/Zirh

The word mark Zirh does not infringe the word and figurative mark Sir. Aural similarity in this case is insufficient to assume infringement.

'That global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately.' (Para. 35, reference to Picasso/Picaro).

CJEU 27 April 2006, case C-235/05 P, L'Oréal v OHIM – Revlon; Flex/Flexi Air

Revlon opposed the registration of the word mark 'Flexi Air' by L'Oreal, for hair-care products, on the basis of its word mark 'Flex'.

The Court of First Instance held that, notwithstanding the weak distinctive character of the earlier mark, there was a likelihood of confusion between the signs and, accordingly, between the marks covered by them. 'In that regard, the Court of First Instance cannot be criticised for not having disregarded, in its examination of the similarity of the signs in question, the element 'FLEX', which is common to the marks, on the ground that the earlier mark is only of weak distinctive character. In the first place, it is settled case-law that in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to determine the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed [...].

In addition, the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion.’ (Paras. 39-41).

CJEU 16 July 2011, C-317/10 P, Union Investment Privatfonds GmbH/UniCredito Italiano SpA & OHIM

On the ground of, inter alia, the trademark UNIFONDS and UNIRAK, Union Investment Privatfonds filed an opposition against the registration of the word signs ‘UNIWEB’ and ‘UniCredit Wealth Management’ by UniCredito. Having found the existence of a “series” of trade marks, the Board of Appeal concluded from this, almost automatically, that the relevant public associates the prefix “UNI” with [the appellant] where it is used in relation to fund investments and that there is, therefore, a likelihood of confusion between the trade marks at issue. (Para. 48).

The General Court annulled that judgment because it opined that, despite the ‘series element’, no risk of confusions exists. Hereupon, this decision was then annulled by the ECJ.

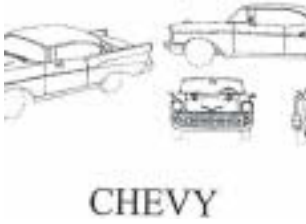
In this case, the global assessment of the likelihood of confusion implies complex assessments of fact in order to verify whether there is, as the Board of Appeal of OHIM found, a risk that the relevant public might believe that the trade marks applied for are part of the series of trade marks cited by the appellant. It is appropriate, therefore, to refer the case back to the General Court to rule again on the actions brought before it by UniCredito and on the applications for partial annulment of the contested decisions presented by the appellant and to reserve the costs of the appeal. (Para. 64).



CJEU 24 May 2012, zaak C-196/11 P, Formula One Licensing/OHIM & Global Sports Media; F1 word/device marks

Comparison of two word/device marks containing the element ‘F1’. The General Court held ‘that consumers regard the ‘F1’ element in an ordinary typography as being the abbreviation of ‘formula 1’, that is to say, a description, and that the public attributes a generic meaning to the sign ‘F1’. Finally, it added, in paragraph 67 of the judgment, that the presence of the letter ‘f’ and the numeral ‘1’ in the mark applied for has no distinctive character.’ (Para. 50).

Although the findings of the judgment under appeal are made with regard to the sign in the earlier trade mark or with regard to the ‘F1’ element in the trade mark applied for, given that the General Court considered, in paragraph 54 of the judgment, that that sign and that element are the same, by doing so the General Court thus held that the sign is generic, descriptive and devoid of any distinctive character. Hence, the General Court called into question the validity of those earlier trade marks in proceedings for registration of a Community trade mark and therefore infringed Article 8(1)(b) of the Trade Mark Regulation. (Para. 51-52).



General Motors objected on the basis of its Benelux word mark Chevy for cars to the use of the Benelux word mark Chevy for cleaning products by Yplon.

Chevy

(reputation)

CJEU 14 September 1999, case C-375/97, General Motors/Yplon; Chevy

Article 5(2) Trade Mark Directive

In the Benelux territory, reputation in a significant part (of one country of) the Benelux is sufficient.

‘Article 5(2) [Trade Mark Directive] [...] is to be interpreted as meaning that, in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers. In the Benelux territory, it is sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory.’ (Operative part).

‘If, at the end of its examination, the national court decides that the condition as to the existence of a reputation is fulfilled, as regards both the public concerned and the territory in question, it must then go on to examine the second condition laid down in Article 5(2) of the Directive, which is that the earlier trade mark must be detrimentally affected without due cause. Here it should be observed that the stronger the earlier mark’s distinctive character and reputation the easier it will be to accept that detriment has been caused to it.’ (Para. 30).



PAGO

(reputation in the EU)

CJEU 6 October 2009, case C-301/07, PAGO/Tirolmilch

Article 9(1)(c) Trade Mark Regulation

A Community trade mark can have a 'reputation', if it is known throughout the territory of one Member State.

PAGO has a figurative trademark for fruit drinks and fruit juices, consisting an image of a green glass bottle with a distinctive label and cap. PAGO markets in Austria a fruit juice called 'Pago' in such bottles. The Community trade mark held by PAGO is widely known in that Member State. Tirolmilch markets, also in Austria, a fruit and whey drink called 'Lattella'. That drink was initially sold in cartons. Subsequently, it has also been packaged in glass bottles. Two bottle designs resemble in several respects the Community trade mark held by PAGO. In its advertising, Tirolmilch uses a representation which, like the Community trade mark held by PAGO, shows a bottle next to a full glass. PAGO objects to Tirolmilch.

The concept of 'reputation' assumes a certain degree of knowledge amongst the relevant public. The relevant public is that concerned by the Community trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialized public, for example traders in a specific sector. It cannot be required that the Community trade mark be known by a given percentage of the public so defined. The degree of knowledge required must be considered to be reached when the Community trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark. (Para. 21-24).

In examining this condition, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it. In view of the elements of the main proceedings, it is thus for the national court to determine whether the Community trade mark at issue is known by a significant part of the public concerned by the goods which that trade mark covers. (Para. 26-27).

Territorially, the condition as to reputation must be considered to be fulfilled when the Community trade mark has a reputation in a substantial part of the territory of the Community. It should be noted that the Court has already ruled that, with regard to a Benelux trade mark, it is sufficient, for the purposes of Article 5(2) of the directive, that it has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries. As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied. (Para. 27-29).

Article 9(1)(c) of [the Trade Marks Regulation] must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the European Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community. (Operative part).



Davidoff/Gofkid

(dilution and similar goods)

**CJEU 9 January 2003, case C-292/00, Davidoff/Gofkid;
Davidoff/Durffee**

Article 4(4)(a) and 5(2) Trade Mark Directive



Article 5(2) Trade Mark Directive (relating to dilution) also applies to use for identical or similar goods or services.

Davidoff objected on the basis of its word and figurative mark Davidoff inter alia smoking articles to the use of the word and figurative mark Durffee by Gofkid, for inter alia accessoires for smokers.

See also: Adidas/Fitnessworld

‘Articles 4(4)(a) and 5(2) [Trade Mark Directive] [...] are to be interpreted as entitling the Member States to provide specific protection for registered trade marks with a reputation in cases where a later mark or sign, which is identical with or similar to the registered mark, is intended to be used or is used for goods or services identical with or similar to those covered by the registered mark.’ (Operative part).

When interpreting Article 5(2) of the Directive one should not exclusively start from the wording, but also the general set-up and purposes of the regulation which this provision is part of should be taken into account. The article cannot be interpreted in such sense that known trade marks would enjoy lesser protection if a sign is used for identical or similar goods or services, than if a sign is used for dissimilar goods or services.

‘On this point, it has not been seriously disputed before the Court that, where a sign is used for identical or similar goods or services, a mark with a reputation must enjoy protection which is at least as extensive as where a sign is used for non-similar goods and services.’ (Paras. 24-26).

Adidas/Fitnessworld

(dilution and embellishment)

**CJEU 23 October 2003, case C-408/01, Adidas/Fitnessworld
Trading; three stripes versus two stripes**

Article 5(2) Trade Mark Directive



Article 5(2) Trade Mark Directive (relating to dilution) also applies to identical or similar goods or services. confusion is not required, it suffices that the public establishes a link. If the public perceives the sign purely as an embellishment there is no trade mark infringement.

Adidas objected on the basis of its 3-stripe figurative mark for sportswear to the use of two stripes on sportswear by Fitnessworld.

See also: Davidoff/Gofkid & CJEU 22 June 2000, case C-425/98, Marca/Adidas.

‘A Member State, where it exercises the option provided by Article 5(2) [Trade Mark Directive] [...], is bound to grant the specific protection in question in cases of use by a third party of a later mark or sign which is identical with or similar to the registered mark with a reputation, both in relation to goods or services which are not similar and in relation to goods or services which are identical with or similar to those covered by that mark. (Operative part).

The protection conferred by Article 5(2) [Trade Mark Directive] is not conditional on a finding of a degree of similarity between the mark with a reputation and the sign such that there exists a likelihood of confusion between them on the part of the relevant section of the public. It is sufficient for the degree of similarity between the mark with a reputation and the sign to have the effect that the relevant section of the public establishes a link between the sign and the mark. (Operative part).

The fact that a sign is viewed as an embellishment by the relevant section of the public is not, in itself, an obstacle to the protection conferred by Article 5(2) [Trade Mark Directive] where the degree of similarity is none the less such that the relevant section of the public establishes a link between the sign and the mark. By contrast, where, according to a finding of fact by the national court, the relevant section of the public views the sign purely as an embellishment, it necessarily does not establish any link with a registered mark, with the result that one of the conditions of the protection conferred by Article 5(2) [Trade Mark Directive] is then not satisfied.’ (Operative part).

Intel

(reputation and dilution)

CJEU 27 November 2008, case C-252/07, Intel Corporation/ CPM United Kingdom

Article 5(2) Trade Mark Directive

The fact that the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of 'a link' between the conflicting marks.

Proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer or a serious likelihood that such a change will occur in the future.

INTEL is a trade mark with a huge reputation for inter alia microprocessors. The proprietor of the trade mark filed an application for a declaration of invalidity against the registration of the word mark INTELMARK for marketing and telemarketing services, claiming that the use of that mark would dilute the earlier trade mark INTEL.

The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the conflicting marks. (Para. 63).

The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and
 - those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
 - the earlier mark is unique in respect of any goods or services,
- does not necessarily imply that there is a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the conflicting marks. (Para. 64).

The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that the current or future use of the later mark is taking unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier mark. (Para. 67).

Proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future. (Para. 77).

It is immaterial, however, for the purposes of assessing whether the use of the later mark is or would be detrimental to the distinctive character of the earlier mark, whether or not the proprietor of the later mark draws real commercial benefit from the distinctive character of the earlier mark. (Para. 78).

The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and
- those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
- the earlier mark is unique in respect of any goods or services, and
- for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark to mind, is not sufficient to establish that the use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, within the meaning of Article 4(4)(a) of the Directive. (Para. 80).

Article 4(4)(a) of the Directive must be interpreted as meaning that:

- the use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique;
- a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark;
- proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future. (Para. 81).



L'Oréal/Bellure

(taking unfair advantage of a well-known mark)

CJEU 18 June 2009, case C-487/07, L'Oréal/Bellure

Article 5(2) Trade Mark Directive

Protection of the communication, investment and advertising function. Taking unfair advantage of the distinctive character or the reputation of a mark does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark.

It is sufficient that the third party "rides on the coat-tails of the mark with a reputation" in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.

Bellure markets perfumes which are similar in name and appearance and are copies of well-known perfume trade marks, including perfumes of L'Oréal.

The Court has already held that the exclusive right under Article 5(1) (a) of the [Trade Marks Directive] was conferred in order to enable the trade mark proprietor to protect his specific interests as proprietor, that is, to ensure that the trade mark can fulfil its functions and that, therefore, the exercise of that right must be reserved to cases in which a third party's use of the sign affects or is liable to affect the functions of the trade mark. These functions include not only the essential function of the trade mark, which is to guarantee to consumers the origin of the goods or services, but also its other functions, in particular that of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising. (Para. 58).

Article 5(2) of [the Trade Marks Directive] must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. (Operative part in 1).

Article 5(1)(a) of [the Trade Marks Directive] must be interpreted as meaning that the proprietor of a registered trade mark is entitled to prevent the use by a third party, in a comparative advertisement which does not satisfy all the conditions, laid down in Article 3a(1) of [the Misleading and Comparative Advertising Directive], under which comparative advertising is permitted, of a sign identical with that mark in relation to goods or services which are identical with those for which

that mark was registered, even where such use is not capable of jeopardizing the essential function of the mark, which is to indicate the origin of the goods or services, provided that such use affects or is liable to affect one of the other functions of the mark. (Operative part in 2).

Article 3a(1) of [the Misleading and Comparative Advertising Directive], must be interpreted as meaning that an advertiser who states explicitly or implicitly in comparative advertising that the product marketed by him is an imitation of a product bearing a well-known trade mark presents 'goods or services as imitations or replicas' within the meaning of Article 3a(1)(h). The advantage gained by the advertiser as a result of such unlawful comparative advertising must be considered to be an advantage taken unfairly of the reputation of that mark within the meaning of Article 3a(1)(g). (Operative part in 3).

OTHER CASES

Article 8(5) Trade Mark Regulation

Article 8(5) Trade Mark Directive
See also: Intel



ECJ 10 May 2012, case C 100/11 P, Helena Rubinstein & L'Oréal/OHIM & Allergan

Opposition based on earlier trade mark BOTOX against the trade marks BOTOLIST en BOTOCYL was rightly upheld by the OHIM.

The General Court found 'that 'the size of the market share of BOTOX in the United Kingdom, 74.3% in 2003, like the degree of awareness of the trade mark of 75% among the specialised public accustomed to pharmaceutical treatments against wrinkles, is sufficient to substantiate the existence of a considerable degree of recognition on the market.' (Para. 34).

The 'General Court referred to Allergan's argument that the disputed marks were actually intended to take advantage of the distinctive character and repute acquired by BOTOX for the treatment of wrinkles, which would have the effect of decreasing the value of that mark. According to the General Court, those risks were sufficiently serious and real to justify the application of Article 8(5) of Regulation No 40/94. The General Court observed that Helena Rubinstein and L'Oréal had acknowledged at the hearing that, even though their products did not contain the botulinum toxin, they nevertheless intended to take advantage of the image which was associated with that product, which was to be found in the trade mark BOTOX, a trade mark which is unique in that regard.' (Para. 39).

CJEU 14 November 2013, case C-383/12 P, Environmental Manufacturing/ OHIM & Société Elmar Wolf

The General Court lowered the standard of proof in order to find detriment or the risk of detriment to the distinctive character of the earlier mark, and, consequently, erred in law.

'The concept of 'change in the economic behaviour of the average consumer' lays down an objective condition. That change cannot be deduced solely from subjective elements such as consumers' perceptions. The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of the Regulation, in as much as that similarity does not cause any confusion in their minds.' (Para. 37)

'Admittedly, the Regulation and the Court's case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.' (Para. 42).

'None the less, such deductions must not be the result of mere suppositions but must be founded on 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case'.' (Para. 43).



Google France

(adwords)

**CJEU 23 March 2010, cases C-236/08, C-237/08 en C-238/08
Google France**

Article 5(1) and (2) Trade Mark Directive, Article 9(1) Trade Mark Regulation

Adwords similar to trademarks are not allowed if there is a likelihood of confusion to the average internet user.

Google markets keywords for an internet referencing service, which are identical or similar to those covered by trade mark registration for sites offering identical or similar products. The trade mark proprietors object.

In the case where the ad, while not suggesting the existence of an economic link, is vague to such an extent on the origin of the goods or services at issue that normally informed and reasonably attentive internet users are unable to determine, on the basis of the advertising link and the commercial message attached thereto, whether the advertiser is a third party vis-à-vis the proprietor of the trade mark or, on the contrary, economically linked to that proprietor, the conclusion must also be that there is an adverse effect on that function of the trade mark. (Para. 90).

When internet users enter the name of a trade mark as a search term, the home and advertising page of the proprietor of that mark will appear in the list of the natural results, usually in one of the highest positions on that list. That display, which is, moreover, free of charge, means that the visibility to internet users of the goods or services of the proprietor of the trade mark is guaranteed, irrespective of whether or not that proprietor is successful in also securing the display, in one of the highest positions, of an ad under the heading 'sponsored links'. Having regard to those facts, it must be concluded that use of a sign identical with another person's trade mark in a referencing service such as that at issue in the cases in the main proceedings is not liable to have an adverse effect on the advertising function of the trade mark. (Para. 97-98).

Article 5(1)(a) of [the Trade Marks Directive] and Article 9(1)(a) of [the Trade Marks Regulation] must be interpreted as meaning that the proprietor of a trade mark is entitled to prohibit an advertiser from advertising, on the basis of a keyword identical with that trade mark which that advertiser has, without the consent of the proprietor, selected in connection with an internet referencing service, goods or services identical with those for which that mark is registered, in the case where that advertisement does not enable an average internet user, or enables that user only with difficulty, to ascertain whether the goods or services referred to therein originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party. (Operative part in 1).

An internet referencing service provider which stores, as a keyword, a sign identical with a trade mark and organizes the display of advertisements on the basis of that keyword does not use that sign within the meaning of Article 5(1) and (2) of [the Trade Marks Directive] or of Article 9(1) of [the Trade Marks Regulation]. (Operative part in 2).

Article 14 of the Directive on electronic commerce must be interpreted as meaning that the rule laid down therein applies to an internet referencing service provider in the case where that service provider has not played an active role of such a kind as to give it knowledge of, or control over, the data stored. If it has not played such a role, that service provider cannot be held liable for the data which it has stored at the request of an advertiser, unless, having obtained knowledge of the unlawful nature of those data or of that advertiser's activities, it failed to act expeditiously to remove or to disable access to the data concerned. (Operative part in 3).

L'Oréal/eBay

(the use of a trade mark on an online marketplace)



CJEU 12 July 2011, case C-324/09, L'Oréal/eBay

Article 5 Trade Mark Directive and Article 9 Trade Mark Regulation

When an individual sells a product it does not constitute use in the course of trade. The operator of an online marketplace does not 'use' a trade mark.

On eBay pirated second-hand trade mark products are sold inside and outside the EU.

When an individual sells a product bearing a trade mark through an online marketplace and the transaction does not take place in the context of a commercial activity, the proprietor of the trade mark cannot rely on his exclusive right. If, however, owing to their volume, their frequency or other characteristics, the sales made on such a marketplace go beyond the realms of a private activity, the seller will be acting 'in the course of trade' within the meaning of those provisions. (Para. 55).

Where goods located in a third State, which bear a trade mark registered in a Member State of the European Union or a Community trade mark and have not previously been put on the market in the European Economic Area or, in the case of a Community trade mark, in the European Union, (i) are sold by an economic operator on an online marketplace without the consent of the trade mark proprietor to a consumer located in the territory covered by the trade mark or (ii) are offered for sale or advertised on such a marketplace targeted at consumers located in that territory, the trade mark proprietor may prevent that sale, offer for sale or advertising by virtue of the rules set out in Article 5 of the Community trade mark. (Operative part in 1).

Where the proprietor of a trade mark supplies to its authorized distributors items bearing that mark, intended for demonstration to consumers in authorized retail outlets, and bottles bearing the mark from which small quantities can be taken for supply to consumers as free samples, those goods, in the absence of any evidence to the contrary, are not "put on the market". (Operative part in 2).

The proprietor of a trade mark may oppose the resale of goods when their packaging has been removed, where the consequence of that removal is that essential information, such as information relating to the identity of the manufacturer or the person responsible for marketing the cosmetic product, is missing, or when the removal of the packaging has damaged the image of the product and, hence, the reputation of the trade mark. (Operative part in 3).

The proprietor of a trade mark is entitled to prevent an online marketplace operator from advertising – on the basis of a keyword which is identical to his trade mark and which has been selected in an internet referencing service by that operator – goods bearing that trade mark which are offered for sale on the marketplace, where the advertising does not enable reasonably well-informed and reasonably observant internet users, or enables them only with difficulty, to ascertain whether the goods concerned originate from the proprietor of the trade mark or from an undertaking economically linked to that proprietor or, on the contrary, originate from a third party. (Operative part in 4).

The operator of an online marketplace does not ‘use’ – for the purposes of Article 5 of Directive 89/104 or Article 9 of Regulation No 40/94 – signs identical with or similar to trade marks which appear in offers for sale displayed on its site. (Operative part in 5).

Article 14(1) of [the Directive on electronic commerce], must be interpreted as applying to the operator of an online marketplace where that operator has not played an active role allowing it to have knowledge or control of the data stored. The operator plays such a role when it provides assistance which entails, in particular, optimizing the presentation of the offers for sale in question or promoting them. Where the operator of the online marketplace has not played an active role within the meaning of the preceding paragraph and the service provided falls, as a consequence, within the scope of Article 14(1) of [the Directive], the operator none the less cannot, in a case which may result in an order to pay damages, rely on the exemption from liability provided for in that provision if it was aware of facts or circumstances on the basis of which a diligent economic operator should have realized that the offers for sale in question were unlawful and, in the event of it being so aware, failed to act expeditiously in accordance with Article 14(1)(b) of [the Directive]. (Operative part in 6).

Article 11 of [the Enforcement Directive] must be interpreted as requiring the Member States to ensure that the national courts with jurisdiction in relation to the protection of intellectual property rights are able to order the operator of an online marketplace to take measures which contribute, not only to bringing to an end infringements of those rights by users of that marketplace, but also to preventing further infringements of that kind. Those injunctions must be effective, proportionate, and dissuasive and must not create barriers to legitimate trade. (Operative part in 7).



Interflora/ Marks & Spencer

(adwords)

CJEU 22 September 2011, case C-323/09, Interflora/Marks & Spencer

Article 5(1)(a) and (2) Trade Mark Directive

Non-misleading use of a trade mark as an Adword, does not have an adverse effect on the functions of that trade mark.

Interflora objects to the use of the word Interflora as an Adword by Marks & Spencer.

The proprietor of a trade mark is entitled to prevent a competitor from advertising with an Adword which is identical with the trade mark, where that use is liable to have an adverse effect on one of the functions of the trade mark. Such use:

- adversely affects the trade mark's function of indicating origin where the advertising displayed on the basis of that keyword does not enable reasonably well-informed and reasonably observant internet users, or enables them only with difficulty, to ascertain whether the goods or services concerned by the advertisement originate from the proprietor of the trade mark or an undertaking economically linked to that proprietor or, on the contrary, originate from a third party;
- does not adversely affect, in the context of an internet referencing service having the characteristics of the service at issue in the main proceedings, the trade mark's advertising function, and
- adversely affects the trade mark's investment function if it substantially interferes with the proprietor's use of its trade mark to acquire or pre-serve a reputation capable of attracting consumers and retaining their loyalty. (Operative part in 1).

The proprietor of a trade mark with a reputation is entitled to prevent a competitor from advertising on the basis of a key-word corresponding to that trade mark, which the competitor has, without the proprietor's consent, selected in an internet referencing service, where the competitor thereby takes unfair advantage of the distinctive character or repute of the trade mark (free-riding) or where the advertising is detrimental to that distinctive character (dilution) or to that repute (tarnishment).

Advertising on the basis of such a keyword is detrimental to the distinctive character of a trade mark with a reputation (dilution) if, for example, it contributes to turning that trade mark into a generic term.

The proprietor of a trade mark with a reputation is not entitled to prevent, inter alia, advertisements displayed by competitors on the basis of keywords corresponding to that trade mark, which put forward – without offering a mere imitation of the goods or services of the proprietor of that trade mark, without causing dilution or tarnishment and without, moreover, adversely affecting the functions of the trade mark with a reputation – an alternative to the goods or services of the proprietor of that mark. (Operative part in 2).

Such use falls, as a rule, within the ambit of fair competition in the sector for the goods or services concerned and is thus not without 'due cause' for the purposes of Article 5(2) of the Directive. (Para. 91).

INFRINGEMENT
(OTHER)



Under an order of a party from outside the EU, Winters fills cans which infringe the trade marks of Red Bull, with energy drink.



Winters/Red Bull

(filling in order)

CJEU 15 December 2011, case C-119/10, Winters/Red Bull

Article 5(1)(b) Trade Mark Directive

Filling infringing cans under an order from another person, which are destined for outside the EU does not constitute use of trade mark.

A service provider who, merely fills, under an order from, and under the instructions of another person, cans already bearing signs similar to trade marks and therefore merely executes a technical part of the production process of the final product without having any interest in the external presentation of those cans and in particular in the signs thereon, does not itself 'use' those signs which can be prohibited on basis of the Directive. He only creates the technical conditions necessary for the other person to use them. (Para. 30).

Moreover, a service provider in Winters' situation does not, on any view, use those signs 'for goods or services' which are identical with, or similar to, those for which the trade mark was registered, within the meaning of that article. It is established that in the main action the service provided by Winters consists of the filling of cans and that this service does not have any similarity with the product for which Red Bull's trade marks were registered. (Para. 31).

It is true that the Court has also held that that expression may, under certain conditions, include goods and services of another person on whose behalf the third party acts. Thus, the Court considered that a situation in which the service provider uses a sign corresponding to the trade mark of another person in order to promote goods which one of its customers is marketing with the assistance of that service is covered by that same expression when that use is carried out in such a way that it establishes a link between that sign and that service. (Para. 32).

Specsavers/Asda

(trade mark as used)

CJEU 18 July 2013, case C-252/12, Specsavers/Asda

Article 9(1)(b) and (c) Trade Mark Regulation



The form in which a trade mark is used (e.g., the colour) is relevant in the assessment of the risk of confusion or unfair advantage.

Supermarket chain Asda launched an advertising campaign for spectacles. As a part of this campaign it used logos and a colour green similar to those of Specsavers. The colour green was already the colour associated with Asda. Furthermore, Asda used the slogans: “Be a real spec saver at Asda” and “Spec savings at ASDA”.

‘Where a Community trade mark is not registered in colour, but the proprietor has used it extensively in a particular colour or combination of colours with the result that it has become associated in the mind of a significant portion of the public with that colour or combination of colours, the colour or colours which a third party uses in order to represent a sign alleged to infringe that trade mark are relevant in the global assessment of the likelihood of confusion or unfair advantage under that provision. (Operative part 2).

On the other hand it is relevant ‘that the third party making use of a sign which allegedly infringes the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation.’ (Operative part 3).



‘the fact that the third party making use of a sign which is alleged to infringe the registered trade mark is itself associated, in the mind of a significant portion of the public, with the colour or particular combination of colours which it uses for the representation of that sign can be relevant to determining whether the use of that sign has a ‘due cause’’. (Para. 49).



Evora operated a chain of chemistshops called Kruidvat, which used in an advertising leaflet reproductions of (lawfully parallel imported) trade-marked perfumes (Eau sauvage, Poison, Fahrenheit and Dune) of Dior. Dior objected to this under copyright law and trade mark law.

Dior/Evora

(advertising by reseller)

CJEU 4 November 1997, case C-337/95, Dior/Evora

Article 5 and 7 Trade Mark Directive

The reseller of a branded product is allowed to use the trade mark in his advertising for resale of this product.

‘On a proper interpretation of Articles 5 and 7 [Trade Mark Directive], when trade-marked goods have been put on the Community market by the proprietor of the trade mark or with his consent, a reseller, besides being free to resell those goods, is also free to make use of the trade mark in order to bring to the public’s attention the further commercialization of those goods.

The proprietor of a trade mark may not rely on Article 7(2) [Trade Mark Directive] to oppose the use of the trade mark, by a reseller who habitually markets articles of the same kind, but not necessarily of the same quality, as the trade-marked goods, in ways customary in the reseller’s sector of trade, for the purpose of bringing to the public’s attention the further commercialization of those goods, unless it is established that, given the specific circumstances of the case, the use of the trade mark for this purpose seriously damages the reputation of the trade mark.

On a proper interpretation of Articles 30 and 36 of the EC Treaty, the proprietor of a trade mark or holder of copyright may not oppose their use by a reseller who habitually markets articles of the same kind, but not necessarily of the same quality, as the protected goods, in ways customary in the reseller’s sector of trade, for the purpose of bringing to the public’s attention the further commercialization of those goods, unless it is established that, having regard to the specific circumstances of the case, the use of those goods for that purpose seriously damages their reputation.’ (Operative part).



Arsenal/Reed

(badge of support)

**CJEU 12 November 2002, case C-206/01, Arsenal/
Matthew Reed**

Article 5(1)(a) and 6 Trade Mark Directive

Affixing trade marks of soccer clubs on shawls and the like is trade mark use in the sense of art. 5(1)(a) trade mark directive. A disclaimer at the point of sale is no remedy.

Reed sold shawls provided with Arsenal marks. In his stall a notice stated: 'The word or logo(s) on the goods offered for sale, are used solely to adorn the product and does not imply or indicate any affiliation or relationship with the manufacturers or distributors of any other product, only goods with official Arsenal merchandise tags are official Arsenal merchandise'.

'Having regard to the presentation of the word Arsenal on the goods at issue in the main proceedings and the other secondary markings on them (see paragraph 39 above), the use of that sign is such as to create the impression that there is a material link in the course of trade between the goods concerned and the trade mark proprietor. (Para. 56).

That conclusion is not affected by the presence on Mr Reed's stall of the notice stating that the goods at issue in the main proceedings are not official Arsenal FC products (see paragraph 17 above). Even on the assumption that such a notice may be relied on by a third party as a defence to an action for trade mark infringement, there is a clear possibility in the present case that some consumers, in particular if they come across the goods after they have been sold by Mr Reed and taken away from the stall where the notice appears, may interpret the sign as designating Arsenal FC as the undertaking of origin of the goods.' (Para. 57).

'In a situation which is not covered by Article 6(1) [Trade Mark Directive] [...], where a third party uses in the course of trade a sign which is identical to a validly registered trade mark on goods which are identical to those for which it is registered, the trade mark proprietor of the mark is entitled, in circumstances such as those in the present case, to rely on Article 5(1)(a) of that directive to prevent that use. It is immaterial that, in the context of that use, the sign is perceived as a badge of support for or loyalty or affiliation to the trade mark proprietor.' (Operative part).

The English court of reference refused to apply the decision, because the CJEU had proceeded to establish itself the facts in a different way (High Court 12 December 2002). The Court of Appeal did however follow (the establishment of facts of) the CJEU (Court of Appeal 21 May 2003).



Gerri/Kerry Spring

(indication of geographical origin)

**CJEU 7 January 2004, case C-100/02, Gerolsteiner Brunnen/
Putsch; Gerry/Kerry**

Article 6(1)(b) Trade Mark Directive

Likelihood of aural confusion between an indication of geographical origin and a word mark is not decisive, the point is whether the use is in accordance with honest trade practices.

Gerolsteiner Brunnen objects by reason of its word mark Gerri for mineral water to the fact that Putsch markets soft drinks in Germany with labels containing the words 'Kerry Spring'. These drinks are produced by the Irish company Kerry Spring Water with water from the Kerry Spring and bottled in Ballyferriter, in the county of Kerry in Ireland.

‘The mere fact that there exists a likelihood of aural confusion between a word mark registered in one Member State and an indication of geographical origin from another Member State is therefore insufficient to conclude that the use of that indication in the course of trade is not in accordance with honest practices. In a Community of 15 Member States, with great linguistic diversity, the chance that there exists some phonetic similarity between a trade mark registered in one Member State and an indication of geographical origin from another Member State is already substantial and will be even greater after the impending enlargement.’(Para. 25).

‘Article 6(1)(b) [Trade Mark Directive] [...] is to be interpreted as meaning that, where there exists a likelihood of aural confusion between a word mark registered in one Member State and an indication, in the course of trade, of the geographical origin of a product originating in another Member State, the proprietor of the trade mark may, pursuant to Article 5 [Trade Mark Directive], prevent the use of the indication of geographical origin only if that use is not in accordance with honest practices in industrial or commercial matters. It is for the national court to carry out an overall assessment of all the circumstances of the particular case in that regard.’ (Operative part).

‘It follows that, in a case such as that in the main proceedings, it is for the national court to carry out an overall assessment of all the relevant circumstances. Since the case concerns bottled drinks, the circumstances to be taken into account by that court would include in particular the shape and labelling of the bottle in order to assess, more particularly, whether the producer of the drink bearing the indication of geographical origin might be regarded as unfairly competing with the proprietor of the trade mark.’ (Para. 26).

Tähän terään
SOPIVAT
kaikki parason
FLEXOR
Ja kaikki Gillette
SENSOR
VARRETI



The packaging of the razorblades of LA-laboratories contained the following text: 'All handles of Parason Flexor and of Gillette Sensor are compatible with this blade'.

Gillette/LA-Laboratories

(indication of the intended purpose)

CJEU 17 March 2005, C-228/03, Gillette/LA-Laboratories

Article 6(1)(c) Trade Mark Directive

Use of a trade mark to indicate the intended use of a good is allowed if it is necessary.

'Use of the trade mark by a third party who is not its owner is necessary in order to indicate the intended purpose of a product marketed by that third party where such use in practice constitutes the only means of providing the public with comprehensible and complete information on that intended purpose in order to preserve the undistorted system of competition in the market for that product.

The condition of 'honest use' within the meaning of Article 6(1)(c) [Trade Mark Directive], constitutes in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark owner.

The use of the trade mark will not be in accordance with honest practices in industrial and commercial matters if, for example:

- it is done in such a manner as to give the impression that there is a commercial connection between the third party and the trade mark owner;
- it affects the value of the trade mark by taking unfair advantage of its distinctive character or repute;
- it entails the discrediting or denigration of that mark;
- or where the third party presents its product as an imitation or replica of the product bearing the trade mark of which it is not the owner.

The fact that a third party uses a trade mark of which it is not the owner in order to indicate the intended purpose of the product which it markets does not necessarily mean that it is presenting it as being of the same quality as, or having equivalent properties to, those of the product bearing the trade mark.

Where a third party that uses a trade mark of which it is not the owner markets not only a spare part or an accessory but also the product itself with which the spare part or accessory is intended to be used, such use falls within the scope of Article 6(1)(c) [Trade Mark Directive] in so far as it is necessary to indicate the intended purpose of the product marketed by the latter and is made in accordance with honest practices in industrial and commercial matters.' (Operative part).



Spirit Sun and Context Cut are word marks of Freiesleben for gems of two special cutting shapes. Hölderhoff used these marks as reference to cutting shapes of his own products in a transaction with a jeweller.

Hölderhoff/Freiesleben

(use to indicate characteristics)

**CJEU 14 May 2002, case C- 2/00, Hölderhoff/Freiesleben;
Spirit Sun & Context Cut**

Article 5(1) Trade Mark Directive

If someone uses a sign solely to denote the particular characteristics of the goods he is offering for sale so that there can be no question of the trade mark used being perceived as a sign indicative of the undertaking of origin, article 5(1) of the directive does not apply.

‘Article 5(1) [Trade Mark Directive] is to be interpreted as meaning that the proprietor of a trade mark cannot rely on his exclusive right where a third party, in the course of commercial negotiations, reveals the origin of goods which he has produced himself and uses the sign in question solely to denote the particular characteristics of the goods he is offering for sale so that there can be no question of the trade mark used being perceived as a sign indicative of the undertaking of origin.’ (Operative part).

Portakabin/Primakabin

(adwords and exhaustion)

CJEU 8 July 2010, case C-558/08, Portakabin/Primakabin

Article 6 and 7 Trade Mark Directive

Confusing use of a trade mark as an Adword in principle is not allowed. Exhaustion or descriptive use or other legitimate reasons can be a justification.

Primakabin uses the trade mark Portakabin as Adword for the resell of second-hand Portakabin cabins.

A trade mark proprietor is entitled to prohibit an advertiser from advertising, on the basis of a keyword identical with, or similar to, that mark, in relation to goods or services identical to those in respect of which the mark is registered, where that advertising does not enable average internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the ad originate from the proprietor of the trade mark or from an undertaking economically linked to it or, on the contrary, originate from a third party. (Operative part in 1).

Advertisers cannot, in general, rely on the exception provided for in Article 6(1) in order to avoid such a prohibition. It is, however, for the national court to determine, in the light of the particular circumstances of the case, whether or not there was, in fact, a use, within the terms of Article 6(1), which could be regarded as having been made in accordance with honest practices in industrial or commercial matters. (Operative part in 2).

Article 7 of [the Trade Marks Directive] must be interpreted as meaning that a trade mark proprietor is not entitled to prohibit an advertiser from advertising the resale of goods manufactured and placed on the market in the European Economic Area by that proprietor or with his consent, unless there is a legitimate reason, within the meaning of Article 7(2), which justifies him opposing that advertising, such as use of that sign which gives the impression that the reseller and the trade mark proprietor are economically linked or use which is seriously detrimental to the reputation of the mark.

The national court, which must assess whether or not there is such a legitimate reason in the case before it:

- cannot find that the ad gives the impression that the reseller and the trade mark proprietor are economically linked, or that the ad is seriously detrimental to the reputation of that mark, merely on the basis that an advertiser uses another person's trade mark with additional wording indicating that the goods in question are being resold, such as 'used' or 'second-hand';
- is obliged to find that there is such a legitimate reason where the reseller, without the consent of the proprietor of the trade mark which it uses in the context of advertising for its resale activities,

has removed reference to that trade mark from the goods, manufactured and placed on the market by that proprietor, and replaced it with a label bearing the reseller's name, thereby concealing the trade mark; and

- is obliged to find that a specialist reseller of second-hand goods under another person's trade mark cannot be prohibited from using that mark to advertise to the public its resale activities which include, in addition to the sale of secondhand goods under that mark, the sale of other second-hand goods, unless the sale of those other goods, in the light of their volume, their presentation or their poor quality, risks seriously damaging the image which the proprietor has succeeded in creating for its mark. (Operative part in 3).

Viking Gas/Kosan Gas

(refilling)

CJEU 14 July 2011, case C-46/10, Viking Gas/Kosan Gas

Article 5 and 7 Trade Mark Directive

Refilling of gas bottles of which the shape is protected as a three-dimensional mark is allowed.

Kosan Gas markets LPG in 'composite bottles' (light weight bottles). The special shape of these bottles is protected as a three-dimensional trade mark. Kosan Gas objects to the refilling of these bottles by Viking gas.

Composite bottles, which are intended for reuse a number of times, do not constitute mere packaging of the original product, but have an independent economic value and must be regarded as goods in themselves. (Para. 30).

A balance must be struck between, on the one hand, the legitimate interest on the part of the licensee of the right to the trade mark constituted by the shape of the composite bottle and the proprietor of the marks affixed to that bottle in profiting from the rights attached to those marks and, on the other, the legitimate interests of purchasers of those bottles, in particular the interest in fully enjoying their property rights in those bottles, and the general interest in maintaining undistorted competition. (Para. 31).

As regards the interest of that licensee and proprietor in profiting from the rights attached to those marks, it must be pointed out that the sale of composite bottles allows it to realise the economic value of the marks relating to those bottles. (Para. 32).

The bottles from being refilled would unduly reduce competition on the downstream market for the refilling of gas bottles, and would even create the risk of that market's being closed off if the licensee and proprietor were to succeed in imposing its bottle because of its specific technical characteristics, the protection of which is not the purpose of trade mark law. That risk is, moreover, increased by virtue of the fact that the cost of the composite bottle is much more than the gas and that the purchaser, in order to regain a free choice of gas supplier, would have to forgo the initial outlay made in purchasing the bottle, the recouping of which requires the bottle to be reused a sufficient number of times. (Para. 34).

The holder of an exclusive licence for the use of composite gas bottles intended for re-use, the shape of which is protected as a three-dimensional mark and to which the holder has affixed its own name and logo that are registered as word and figurative marks, may not prevent those bottles, after consumers have purchased them and consumed the gas initially contained in them, from being ex-changed by a third party, on payment, for composite bottles filled with gas which does not come from the holder of that licence, unless that holder is able to rely on a proper reason for the purposes of Article 7(2) of Directive 89/104. (Operative part).

Silhouette/Hartlauer

(european exhaustion)

**CJEU 16 July 1998, case C-355/96, *Silhouette/Hartlauer*;
*Silhouette spectacles***

Article 7(1) Trade Mark Directive



Only if a product bearing a trade mark is put on the market within the EU (or EEA) with the consent of the trade mark owner the right to enforce the trade mark right is exhausted.

Hartlauer imported original, obsolete spectacle frames of the trade mark Silhouette from Bulgaria (i.e. 'parallel' trade from outside the EU and EEA). Trade mark owner Silhouette opposed to the import.

See also: Sebago/G-B Unic

'In the light of those recitals, Articles 5 to 7 of the Directive must be construed as embodying a complete harmonisation of the rules relating to the rights conferred by a trade mark. (Para. 25).

That interpretation, it may be added, is borne out by the fact that Article 5 expressly leaves it open to the Member States to maintain or introduce certain rules specifically defined by the Community legislature. Thus, in accordance with Article 5(2), to which the ninth recital refers, the Member States have the option to grant more extensive protection to trade marks with a reputation.' (Para. 26).

'Moreover this interpretation is the only one which is fully in line with the purpose of the Directive, i.e. to ensure the operation of the internal market. A situation in which some Member States may provide in international exhaustion and others only in Community exhaustion, would after all inevitably result into restrictions of the free movement of goods and services.' (Paras. 27).

'Article 7(1) [Trade Mark Directive] cannot be interpreted as meaning that the proprietor of a trade mark is entitled, on the basis of that provision alone, to obtain an order restraining a third party from using his trade mark for products which have been put on the market outside the European Economic Area under that mark by the proprietor or with his consent.' (Operative part).

Van Doren + Q/Listyle ; Stüssy

(burden of proof)

**CJEU 8 April 2003, case C-244/00, Van Doren + Q/Lifestyle;
Stüssy**

Article 7(1) Trade Mark Directive

The parallel importer has to prove that the goods originate from inside the EU. If there is a real risk that national markets will be partitioned, the burden of proof may, however, rest upon the trade mark owner.



Lifestyle parallel imported clothing of the trade mark Stüssy into the EEA. Van Doorne was exclusive importer and objected to this.

‘A rule of evidence according to which exhaustion of the trade mark right constitutes a plea in defence for a third party against whom the trade mark proprietor brings an action, so that the existence of the conditions for such exhaustion must, as a rule, be proved by the third party who relies on it, is consistent with Community law and, in particular, with Articles 5 and 7 [Trade Mark Directive] [...], as amended by the Agreement on the European Economic Area of 2 May 1992.

However, the requirements deriving from the protection of the free movement of goods enshrined, inter alia, in Articles 28 EC and 30 EC may mean that this rule of evidence needs to be qualified. Accordingly, where a third party succeeds in establishing that there is a real risk of partitioning of national markets if he himself bears that burden of proof, particularly where the trade mark proprietor markets his products in the European Economic Area using an exclusive distribution system, it is for the proprietor of the trade mark to establish that the products were initially placed on the market outside the European Economic Area by him or with his consent. If such evidence is adduced, it is for the third party to prove the consent of the trade mark proprietor to subsequent marketing of the products in the European Economic Area.’ (Operative part).



Class International

(in transit)

CJEU 18 October 2005, case C-405/03, Class/SmithKline Beecham; Aquafresh toothpaste

Article 5(1) and (3)(c) Trade Mark Directive

Article 9(1) and (2)(c) Trade Mark Regulation

As long as 'parallel' imported goods are 'in transit' and no final destination within the Community has been established, there is no trade mark infringement.

Class International brought a container with toothpaste bearing the mark Aquafresh from South Africa into the Community in Rotterdam. Trade mark owner Beecham seized the goods when they were 'in transit'.

The trade mark owner cannot oppose 'the mere entry into the Community, under the external transit procedure or the customs warehousing procedure, of original goods bearing that mark which had not already been put on the market in the Community previously by that proprietor or with his consent. The trade mark proprietor cannot make the placing of the goods at issue under the external transit procedure or the customs warehousing procedure conditional on the existence, at the time of the introduction of those goods into the Community, of a final destination already specified in a third country, possibly pursuant to a sale agreement.' (Operative part in 1).

'Offering' and 'putting on the market' the goods, within the meaning of Article 5(3)(b) [Trade Mark Directive] and Article 9(2)(b) [Trade Mark Regulation], may include, respectively, the offering and sale of original goods bearing a trade mark and having the customs status of non-Community goods, when the offering is done and/or the sale is effected while the goods are placed under the external transit procedure or the customs warehousing procedure. The trade mark proprietor may oppose the offering or the sale of such goods when it necessarily entails the putting of those goods on the market in the Community.' (Operative part in 2).

'In a situation such as the one at issue in the main proceedings, it is for the trade mark proprietor to prove the facts which would give grounds for exercising the right of prohibition provided for in Article 5(3)(b) and (c) [Trade Mark Directive] and Article 9(2)(b) and (c) [Trade Mark Regulation], by proving either release for free circulation of the non-Community goods bearing his mark or an offering or sale of the goods which necessarily entails their being put on the market in the Community.' (Operative part in 3).

Under the Piracy Regulation, seizure of imitation goods 'in transit' is, possible, also if these goods are in transit to outside the EU. See: CJEU 6 April 2000, case C-383/98 (Polo/Dwidua) (not included).



Diesel objects to the marketing of Diesel-shoes by Makro. Marko states that these shoes were placed on the EEA market by a licensee, and consequently with implied consent, of Diesel.

Makro/Diesel

(consent)

CJEU, 15 October 2009, case C-324/08, Makro/Diesel

Article 7(1) Trade Mark Directive

Consent of placing of goods on the market can be implicit, providing that in the view of the national court it is unequivocally demonstrated that the proprietor has renounced his exclusive rights.

Article 5 of the directive confers on the trade mark proprietor exclusive rights which entitle him, inter alia, to prevent any third party from importing goods bearing the mark, offering the goods, or putting them on the market or stocking them for these purposes. Article 7(1) of the directive contains an exception to that rule, in that it provides that the trade mark proprietor's rights are exhausted where the goods have been put on the market in the EEA by him or with his consent. It is therefore apparent that consent, which is tantamount to the proprietor's renunciation of his exclusive rights within the meaning of Article 5, constitutes the decisive factor in the extinction of those rights and must, therefore, be so expressed that an intention to renounce those rights is unequivocally demonstrated. Such an intention will normally be gathered from an express statement of that consent. (Para. 21-23).

The requirements deriving from the protection of the free movement of goods, enshrined, inter alia, in Articles 28 EC and 30 EC, have led the Court to hold that such a rule can be qualified. Thus, the Court has held that exhaustion of the exclusive rights can occur, inter alia, when the goods are put on the market by an operator with economic links to the proprietor of the trade mark, for example a licensee. When the goods in question were first placed on the market in the EEA by a person having no economic link to the proprietor of the trade mark and without his express consent, the intention to renounce the exclusive rights provided for in Article 5 may result from that proprietor's implied consent. (Para. 23-25).

Article 7(1) of First Council Directive 89/104/EEC must be interpreted as meaning that the consent of the proprietor of a trade mark to the marketing of goods bearing that mark carried out directly in the European Economic Area by a third party who has no economic link to that proprietor may be implied, in so far as such consent is to be inferred from facts and circumstances prior to, simultaneous with or subsequent to the placing of the goods on the market in that area which, in the view of the national court, unequivocally demonstrate that the proprietor has renounced his exclusive rights. (Para. 35).

Copad/Dior

(damage to the aura of luxury goods)

CJEU 23 April 2009, case C-59/08, Copad/Dior

Article 7 and 8 Trade Mark Directive

A trade mark proprietor can invoke the sale of goods by a licensee if that sale does impair the stature and the prestigious image of the luxurious goods.

Despite of a refusal and in breach of its contractual obligations, SIL sold to Copad, a company operating a discount store business, prestigious corsets bearing the Christian Dior trade mark.

Article 8(2) of [the Trade Marks Directive] is to be interpreted as meaning that the proprietor of a trade mark can invoke the rights conferred by that trade mark against a licensee who contravenes a provision in a license agreement prohibiting, on grounds of the trade mark's prestige, sales to discount stores of goods such as the ones at issue in the main proceedings, provided it has been established that that contravention, by reason of the situation prevailing in the case in the main proceedings, damages the allure and prestigious image which bestows on those goods an aura of luxury. (Operative part in 1).

Article 7(1) of [the Trade Marks Directive] is to be interpreted as meaning that a licensee who puts goods bearing a trade mark on the market in disregard of a provision in a license agreement does so without the consent of the proprietor of the trade mark where it is established that the provision in question is included in those listed in Article 8(2) of that Directive. (Operative part in 2).

Where a licensee puts luxury goods on the market in contravention of a provision in a license agreement but must nevertheless be considered to have done so with the consent of the proprietor of the trade mark, the proprietor of the trade mark can rely on such a provision to oppose a resale of those goods on the basis of Article 7(2) of [the Trade Marks Directive], only if it can be established that, taking into account the particular circumstances of the case, such resale damages the reputation of the trade mark. (Operative part in 3).

Coty/Simex

(no exhaustion on perfume testers)

CJEU 3 June 2010, case C-127/09, Coty/Simex

Article 7 Trade Mark Directive and Article 13 Trade Mark Regulation

Exhaustion does not apply to “perfume testers” which are not for sale.

Simex Trading markets “perfume testers” of trade marks such as Coty Prestige. According to the conditions of the contract, the testers remain the property of the trade mark proprietor, only their contents being made available for use, and not for sale and have been putted on the market outside of the European Union.

The rights conferred by the trade mark are exhausted only if, according to an assessment which it is for the national court to make, it may be concluded that the proprietor of the mark expressly or impliedly consented to a putting on the market, either in the European Community or in the European Economic Area, of the goods in respect of which that exhaustion is claimed to exist. (Operative part in 1).

In circumstances such as those of the main proceedings, where ‘perfume testers’ are made available, without transfer of ownership and with a prohibition on sale, to intermediaries who are contractually bound to the trade mark proprietor for the purpose of allowing their customers to test the contents, where the trade mark proprietor may at any time recall those goods and where the presentation of the goods is clearly distinguishable from that of the bottles of perfume normally made available to the intermediaries by the trade mark proprietor, the fact that those testers are bottles of perfume which bear not only the word ‘Demonstration’ but also the statement ‘Not for Sale’ precludes, in the absence of any evidence to the contrary, which it is for the national court to assess, a finding that the trade mark proprietor impliedly consented to putting them on the market. (Operative part in 2).

OTHER CASES ON PARALLEL TRADE

Article 7(1) Trade Mark Directive

CJEU 1 July 1999, case C-173/98, Sebago/G-B Unic; Docksides

For there to be consent within the meaning of Article 7(1) of the directive, 'such consent must relate to each individual item of the product in respect of which exhaustion is pleaded'.

CJEU 20 November 2001, cases C-414/99 and C-415/99, Zino Davidoff/A & G Imports, Levi Strauss/Tesco and Costco; Cool water & Levi's

The consent of the trade mark owner for import within the EEA may be implied. However, an 'implied consent cannot be inferred:

- from the fact that the proprietor of the trade mark has not communicated to all subsequent purchasers of the goods placed on the market outside the European Economic Area his opposition to marketing within the European Economic Area;
- from the fact that the goods carry no warning of a prohibition of their being placed on the market within the European Economic Area;
- from the fact that the trade mark proprietor has transferred the ownership of the products bearing the trade mark without imposing any contractual reservations and that, according to the law governing the contract, the property right transferred includes, in the absence of such reservations, an unlimited right of resale or, at the very least, a right to market the goods subsequently within the European Economic Area.'

'With regard to exhaustion of the trade mark proprietor's exclusive right, it is not relevant:

- that the importer of goods bearing the trade mark is not aware that the proprietor objects to their being placed on the market in the European Economic Area or sold there by traders other than authorised retailers, or
- that the authorised retailers and wholesalers have not imposed on their own purchasers contractual reservations setting out such opposition, even though they have been informed of it by the trade mark proprietor.' (Operative part).

CJEU 30 November 2004, case C-16/03, Peak Holding/Axolin-Elinor; Peak Performance

'Article 7(1) [Trade Mark Directive], as amended by the Agreement on the European Economic Area of 2 May 1992, must be interpreted as meaning that goods bearing a trade mark cannot be regarded as having been put on the market in the European Economic Area where the proprietor of the trade mark has imported them into the European Economic Area with a view to selling them there or where he has offered them for sale to consumers in the European Economic Area, in his own shops or those of an associated company, without actually selling them.

In circumstances such as those of the main proceedings, the stipulation, in a contract of sale concluded between the proprietor of the trade mark and an operator established in the European Economic Area, of a prohibition on reselling in the European Economic Area does not mean that there is no putting on the market in the European Economic Area within the meaning of Article 7(1) [Trade Mark Directive], as amended by the Agreement on the European Economic Area, and thus does not preclude the exhaustion of the proprietor's exclusive rights in the event of resale in the European Economic Area in breach of the prohibition.' (Operative part).

Paranova

(repackaging)

CJEU 11 July 1996, cases C-427/93, C-429/93 and C-436/93, Bristol-Myers Squibb and Boehringer/Paranova

Article 7(2) Trade Mark Directive

Repackaging of medicines for parallel import is allowed, if this is necessary, if the product and the reputation are not prejudiced and the trade mark owner has been informed.

Paranova parallel imported medicine of Bristol-Myers Squibb from Greece and other EU countries where the prices were low and sold them with profit in Denmark. The medicines were provided with other outer packaging and/or labels.

The trade mark owner may oppose the repackaging of a pharmaceutical product under Article 7(2) Trade Mark Directive, unless:

1. this would contribute to the artificial partitioning of the markets between Member States; such is the case, in particular, where the trade mark owner sells an identical pharmaceutical product in different packaging in several Member States and the repackaging is necessary in order to market the product in the Member State of importation, and also carried out in such conditions that the original condition of the product cannot be affected by it;
2. it is shown that the repackaging cannot affect the original condition of the product inside the packaging. In particular if only a new outer packaging is applied or a label is adhered;
3. the new packaging clearly states who repackaged the product and the name of the manufacturer;
4. the presentation of the repackaged product is not such as to be liable to damage the reputation of the trade mark and of its owner; thus, the packaging must not be defective, of poor quality, or untidy; and
5. the importer gives notice to the trade mark owner before the repackaged product is put on sale, and, on demand, supplies him with a specimen of the repackaged product.' (abbreviated version of Operative part).

Boehringer Ingelheim/ Swingward

(additional external label and repackaging)

CJEU 26 April 2007, case C-348/04, *Boehringer Ingelheim/ Swingward*

Article 7(2) Trade Mark Directive

For repackaging and relabelling of parallel imported medicines, various detailed conditions apply.

Boehringer Ingelheim objects to the repackaging and relabeling of parallel imported medicines by Swingward.

The trade mark owner may legitimately oppose further commercialization of a pharmaceutical product imported from another Member State in its original internal and external packaging with an additional external label applied by the importer, unless:

- it is established that reliance on trade mark rights by the proprietor in order to oppose the marketing of the over stickered product under that trade mark would contribute to the artificial partitioning of the markets between Member States;
- it is shown that the new label cannot affect the original condition of the product inside the packaging;
- the packaging clearly states who over stickered the product and the name of the manufacturer;
- the presentation of the over stickered product is not such as to be liable to damage the reputation of the trade mark and of its proprietor; thus, the label must not be defective, of poor quality, or untidy; and
- the importer gives notice to the trade mark proprietor before the over stickered product is put on sale, and, on demand, supplies him with a specimen of that product. (Operative part in 1).

The condition that the repackaging of the pharmaceutical product, either by re-boxing the product and re-applying the trade mark or by applying a label to the packaging containing the product, be necessary for its further commercialization in the importing Member State, as one of the conditions which, if fulfilled, prevent the proprietor under Article 7(2) of [the Trade Marks Directive], from opposing such commercialization, is directed solely at the fact of repackaging and not at the manner and style of the repackaging. (Operative part in 2).

The condition that the presentation of the pharmaceutical product must not be such as to be liable to damage the reputation of the trade mark and of its proprietor – as a necessary condition for preventing the proprietor, pursuant to Article 7(2) of [the Trade Marks Directive], from legitimately opposing further commercialization of a pharmaceutical product where the parallel importer has either re-boxed the product and re-applied the trade mark or applied a label to the packaging containing the product – is not limited to cases where the repackaging is defective, of poor quality, or untidy. (Operative part in 3).

The question whether the fact that a parallel importer:

- fails to affix the trade mark to the new exterior carton ('de-branding'), or
 - applies either his own logo or house-style or getup or a get-up used for a number of different products ('co-branding'), or
 - positions the additional label so as wholly or partially to obscure the proprietor's trade mark, or
 - fails to state on the additional label that the trade mark in question belongs to the proprietor, or
 - prints the name of the parallel importer in capital letters,
- is liable to damage the trade mark's reputation is a question of fact for the national court to decide in the light of the circumstances of each case. (Operative part in 4).

In situations such as those in the main proceedings, it is for the parallel importers to prove the existence of the conditions that:

- reliance on trade mark rights by the proprietor in order to oppose the marketing of repackaged products under that trade mark would contribute to the artificial partitioning of the markets between Member States;
- the repackaging cannot affect the original condition of the product inside the packaging;
- the new packaging clearly states who repackaged the product and the name of the manufacturer;
- the presentation of the repackaged product is not such as to be liable to damage the reputation of the trade mark and of its proprietor; thus, the repackaging must not be defective, of poor quality, or untidy; and
- the importer must give notice to the trade mark proprietor before the repackaged product is put on sale and, on demand, supply him with a specimen of the repackaged product, and which, if fulfilled, would prevent the proprietor from lawfully opposing the further commercialization of a repackaged pharmaceutical product.

As regards the condition that it must be shown that the repackaging cannot affect the original condition of the product inside the packaging, it is sufficient, however, that the parallel importer furnishes evidence that leads to the reasonable presumption that that condition has been fulfilled. This applies a fortiori also to the condition that the presentation of the repackaged product must not be such as to be liable to damage the reputation of the trade mark and of its proprietor. Where the importer furnishes such initial evidence that the latter condition has been fulfilled, it will then be for the proprietor of the trade mark, who is best placed to assess whether the repackaging is liable to damage his reputation and that of the trade mark, to prove that they have been damaged. (Operative part in 5).

Where a parallel importer has failed to give prior notice to the trade mark proprietor concerning a repackaged pharmaceutical product, he infringes that proprietor's rights on the occasion of any subsequent importation of that product, so long as he has not given the proprietor such notice. The sanction for that infringement must be not only proportionate, but also sufficiently effective and a sufficient deterrent

to ensure that Directive 89/104, as amended by the Agreement on the European Economic Area, is fully effective. A national measure under which, in the case of such an infringement, the trade mark proprietor is entitled to claim financial remedies on the same basis as if the goods had been spurious, is not in itself contrary to the principle of proportionality. It is for the national court, however, to determine the amount of the financial remedies according to the circumstances of each case, in the light in particular of the extent of damage to the trade mark proprietor caused by the parallel importer's infringement and in accordance with the principle of proportionality. (Operative part in 6).

The Wellcome Foundation/Paranova

(repackaging)

CJEU 22 December 2008, case C-276/05, The Wellcome Foundation/Paranova

Article 7(2) Trade Mark Directive

In case of parallel import the (new) packaging should be assessed only against the condition that it should not be such as to be liable to damage the reputation of the trade mark or that of its proprietor. It is for the parallel importer to furnish the proprietor of the trade mark with the information which is necessary and sufficient to enable the latter to determine whether the repackaging of the product under that trade mark is necessary in order to market it in the member state of importation.

The parallel importer repacks a pharmaceutical product in a packaging with a new design, to prevent that the proprietor of the trade mark to enable him to detect weaknesses in his sales organisation and thus combat parallel trade in his products.

Since the presentation of the new packaging of the product does not fall to be assessed against the condition of necessity for the further marketing of the product, it must also not be assessed against the criterion that the adverse effect on the trade mark rights should be the minimum possible. (Para. 27).

It would be inconsistent to accept that there is no need to ascertain whether the presentation of the new packaging of the product in question, chosen by the parallel importer, is necessary for the further marketing of the product and, at the same time, to demand that the importer satisfy the criterion of the minimum possible adverse effect on trade mark rights. (Para. 28).

Therefore, the reply to question 1(b) must be that Article 7(2) of Directive 89/104 is to be interpreted as meaning that, where it is established that repackaging of the pharmaceutical product is necessary for further marketing in the Member State of importation, the presentation of the packaging should be assessed only against the condition that it should not be such as to be liable to damage the reputation of the trade mark or that of its proprietor. (Para. 30).

Taking account of the foregoing, and having regard to the fact that adequate functioning of the notice system presupposes that the interested parties make sincere efforts to respect each other's legitimate interests, it is for the parallel importer to furnish the proprietor of the trade mark with the information which is necessary and sufficient to enable the latter to determine whether the repackaging of the product under that trade mark is necessary in order to market it in the Member State of importation. (Para. 34).

The kind of information to be furnished depends, moreover, on the facts of each case. It cannot, prima facie, be excluded that it may, in exceptional cases, involve disclosing the Member State of export, where the absence of that information would prevent the proprietor of the trade mark from evaluating the need to repackaging. (Para. 35).

In that regard, it should be borne in mind that, in a situation where it is established that the details furnished are used by the proprietor of the trade mark to enable him to detect weaknesses in his sales organisation and thus combat parallel trade in his products, it is under the provisions of the EC Treaty on competition that those engaged in parallel trade should seek protection against action of the latter type. (Para. 36).

It is for the parallel importer to furnish to the proprietor of the trade mark the information which is necessary and sufficient to enable the latter to determine whether the repackaging of the product under that trade mark is necessary in order to market it in the Member State of importation. (Para. 37).

OTHER REPACKAGING DECISIONS

Article 7(2) Trade Mark Directive

CJEU 11 November 1997, case C-349/95, Frits Loendersloot/ Ballentine

‘The owner of trade mark rights may, even if that constitutes a barrier to intra-Community trade, rely on those rights to prevent a third party from removing and then reaffixing or replacing labels bearing the mark which the owner has himself affixed to products he has put on the Community market, unless:

- it is established that the use of the trade mark rights by the owner to oppose the marketing of the relabelled products under that trade mark would contribute to artificial partitioning of the markets between Member States;
- it is shown that the relabelling cannot affect the original condition of the product;
- the presentation of the relabelled product is not such as to be liable to damage the reputation of the trade mark and its owner; and
- the person who relabels the products informs the trade mark owner of the relabelling before the relabelled products are put on sale.’ (Para. 50).

CJEU 12 October 1999, case C-379/97, Upjohn/Paranova; Dalacin

Upjohn put the antibiotic clindamycine in various forms on the market in the Community. In Denmark, Germany and Spain under the mark Dalacin, in France under the mark Dalacine and in the other Member States under the mark Dalacin C. Paranova bought the medicines in one country, repacked them and sold them in another country under the mark used there.

Such repackaging is only allowed if it is ‘objectively necessary’ for the parallel importer to be able to put the product on the market in another country.

CJEU 23 April 2002, case C-443/99, MSD/Paranova

‘Replacement packaging of pharmaceutical products is objectively necessary within the meaning of the Court’s case-law if, without such repackaging, effective access to the market concerned, or to a substantial part of that market, must be considered to be hindered as the result of strong resistance from a significant proportion of consumers to relabelled pharmaceutical products.’ (Operative part).

CJEU 23 April 2002, case C-143/00, Boehringer/Swingward

The trade mark owner is allowed to oppose repackaging, unless this ‘contributes to artificial partitioning of the markets of the Member States’.

‘A parallel importer must, in any event, in order to be entitled to repack-age trade-marked pharmaceutical products, fulfil the requirement of prior notice. If the parallel importer does not satisfy that requirement, the trade mark proprietor may oppose the marketing of the repackaged pharmaceutical product. It is incumbent on the parallel importer himself to give notice to the trade mark proprietor of the intended repack-aging. In the event of dispute, it is for the national court to assess, in the light of all the relevant circumstances, whether the proprietor had

a reasonable time to react to the intended repackaging.' (Operative part in 3).

CJEU 13 July 1966, cases 56-58/64, Grundig, Consten/EC; Gint
Grundig had transferred the trade mark 'Gint' (acronym of Grundig International) to Consten, its exclusive distributor in France. Consten could thus counter parallel import from outside France. The agreement by which the trade mark Gint was transferred (and thus also the intended exercise of the trade mark right) was not considered lawful by the CJEU under Art. 85 (old) EC, at present Art. 81 EC.

CJEU 31 October 1974, case 16/74, Centrafarm/Winthrop; Negram

Trade mark owner Winthrop could not successfully oppose the import into the Netherlands by Centrafarm of the medicine Negram which was put on the market in England by (the parent company of) Winthrop itself.

'In relation to trade marks, the specific subject-matter of the industrial property is the guarantee that the owner of the trade mark has the exclusive right to use that trade mark, for the purpose of putting products protected by the trade mark into circulation for the first time, and is therefore intended to protect him against competitors wishing to take advantage of the status and reputation of the trade mark by selling products illegally bearing that trade mark.' (Para. 8).

CJEU 22 June 1976, case 119/75, Terrapin/Terranova

The German company Terranova opposed the registration in Germany of the trade mark Terrapin by the English company Terrapin on the basis of its own trade mark rights in the word Terranova.

'It is compatible with the provisions of the EEC Treaty relating to the free movement of goods for an undertaking established in a Member State, by virtue of a right to a trade mark and a right to a commercial name which are protected by the legislation of that state, to prevent the importation of products of an undertaking established in another Member State and bearing by virtue of the legislation of that State a name giving rise to confusion with the trade mark and commercial name of the first undertaking, provided that there are no agreements restricting competition and no legal or economic ties between the undertakings and that their respective rights have arisen independently of one another.' (Operative part).

NB: Since the Ideal Standard decision (see below) an independent origin of the rights is no longer required.

CJEU 22 June 1994, case C-9/93, IHT Danziger/Ideal Standard

After a (voluntary) full split-up of trade mark rights, a consent of the trade mark owner leading to exhaustion of rights does no longer exist.

American Standard was owner of the trade mark 'Ideal Standard' through its German and French subsidiary (Ideal-Standard GmbH and Ideal-Standard SA) in Germany and France. The French subsidiary sold this trade mark to SGF which transferred it in its turn to CICH.

A subsidiary of the latter (IHT) sold in Germany products which were produced by CICH in France under the trade mark 'Ideal Standard'. Ideal-Standard GmbH could oppose this:

'The consent inherent in any transfer is not the same consent as the one required for the exhaustion principle to be effective. This requires that the right owner is authorized in the State of import to decide – directly or not – which products can be provided with the trade mark in the State of import, and to check the quality of such products. This authority will, however, end if he loses control over the trade mark by reason of transfer to a third party which does not have any economic relationship with him.' (Para 43).

As to involuntary full split-up the same was already decided in CJEU 17 October 1990, case C-10/89, HAG II (not included).

CJEU 23 October 2003, case C-115/02, Administration des douanes/Rioglass

Rioglass sold to Jann, a company registered in Poland (at that time not an EU member state), a consignment of windscreens, lawfully produced in Spain, intended for various types of cars. Some of the windscreens, intended for use in Peugeot, Citroën or Renault models, bore the logo or trade mark of those manufacturers alongside the Rioglass's trade mark. These windscreens were transported through France and seized there for trade mark infringement.

'Article 28 EC is to be interpreted as precluding the implementation, pursuant to a legislative measure of a Member State concerning intellectual property, of procedures for detention by the customs authorities of goods lawfully manufactured in another Member State and intended, following their transit through the territory of the first Member State, to be placed on the market in a non-member country. (Operative part).



Ajax, a producer of fire extinguishers, applied for the revocation of the trade mark Minimax for fire extinguishers of its competitor Ansul owing due to non use. Ansul had ceased the use of the trade mark for sale of new fire extinguishers, but still had used it for the sale of components and extinguishing substances, for repair and maintenance, as well as on stickers bearing the text 'Ready to use Minimax'.



Ansul/Ajax

(real commercial exploitation)

CJEU 11 March 2003, case C-40/01, Ansul/Ajax; Minimax

Article 12(1) Trade Mark Directive

Genuine use is use to find a real commercial exploitation for the goods or services, excluding symbolic use.

'Article 12(1) [Trade Mark Directive] [...] must be interpreted as meaning that there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark.

When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark.

The fact that a mark that is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.' (Operative part).

La Mer

(a real commercial purpose)

**CJEU 27 January 2004, case C-259/02, La Mer Technology/
Laboratoires Goemar; Laboratoire de la mer**

Article 12(1) Trade Mark Directive

When it serves a real commercial purpose, even minimal use of the mark or use by only a single importer in the Member State concerned can be sufficient to establish genuine use within the meaning of the Directive.

La Mer applied for the revocation of the trade mark 'Laboratoire de la mer' owned by Goemar, claiming that Laboratoires Goemar had not put it to genuine use during the five years preceding.

The High Court of Justice (England & Wales) held that while the sale of the products had during that period generated a very low turnover of some hundreds of pounds sterling, that situation reflected the commercial failure of the company which owned the trade mark rather than use of the trade mark solely for the purpose of maintaining its registration. In addition, the High Court observed that Laboratoires Goemar had, shortly following that same period, recruited a new sales agent in the United Kingdom in order to boost their sales. (Para. 12).

'[...] there is genuine use of a trade mark where it is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by that mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial use of the mark is real in the course of trade, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark. When it serves a real commercial purpose, in the circumstances cited above, even minimal use of the mark or use by only a single importer in the Member State concerned can be sufficient to establish genuine use within the meaning of the Directive.

While [the Trade Mark Directive] makes the classification of use of the trade mark as genuine use consequential only on consideration of the circumstances which pertain in respect of the relevant period and which predate the filing of the application for revocation, it does not preclude, in assessing the genuineness of use during the relevant period, account being taken, where appropriate, of any circumstances subsequent to that filing. It is for the national court to determine whether such circumstances confirm that the use of the mark during the relevant period was genuine or whether, conversely, they reflect an intention on the part of the proprietor to defeat that claim.' (Operative part).



Vitafruit

(no de minimis rule)

CJEU 11 May 2006, case C-416/04 P, The Sunrider/OHIM; Vitafruit

Article 15 Trade Mark Regulation

An de minimis rule, which would not allow the OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot be laid down.

Espadafor Caba opposed the registration of a Community trade mark Vitafruit by The Sunrider on the basis of its national (Spanish) word mark Vitafruit. The Sunrider argued that Espadafor Caba had not put its trade mark to genuine use.

The sale of around 300 [cases] of 12 items each of concentrated juices of various fruits, representing sales of approximately EUR 4 800 to a single Spanish customer during the period from May 1996 to May 1997 can be regarded as genuine use.

Although the scale of the use to which the earlier trade mark was put is limited and although it might be preferable to have more evidence relating to the nature of the use during the relevant period, the facts and evidence put forward by the other party to the proceedings are sufficient for a finding of genuine use.

‘[...] it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A de minimis rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down.’ (Para. 72).

The CJEU also confirmed the ruling by the CFI that ‘herbal and vitamin beverages’ and ‘concentrated fruit juices’ are similar goods. (Para. 86).

Armin Häupl/Lidl Stiftung

(normal use)

CJEU 14 June 2007, case C-246/05, Armin Häupl/Lidl Stiftung

Article 10(1) Trade Mark Directive

Proper reasons for non-use of a trade mark are constituted if the obstacles which make its use impossible or unreasonable, have a direct relationship with a trade mark and are independent of the will of the proprietor of that mark.

A revocation action against the international trade mark Le Chef De Cuisine based on the fact of non-use of the mark in Austria. Dispute about the start of the period of protection and a proper reason of non-use.

It should be noted that the eighth recital in the preamble to the Directive states that 'in order to reduce the total number of trademarks registered [...] in the Community [...] it is essential to require that registered trademarks must actually be used or, if not used, be subject to revocation'. It appears in the light of that recital that it would be contrary to the scheme of Article 12(1) of the [Trade Marks Directive] to confer too broad a scope on the concept of proper reasons for non-use of a mark. Achievement of the objective set out in that recital would be jeopardized if any obstacle, however minimal yet none the less arising independently of the will of the owner of the trade mark, were sufficient to justify its non-use. (Para. 51).

The 'date of the completion of the registration procedure' within the meaning of Article 10(1) of [the Trade Marks Directive] must be determined in each Member State in accordance with the procedural rules on registration in force in that State. (Operative part in 1).

Article 12(1) of [the Trade Marks Directive] must be interpreted as meaning that obstacles having a direct relationship with a trade mark which make its use impossible or unreasonable and which are independent of the will of the proprietor of that mark constitute proper reasons for non-use' of the mark. It is for the national court or tribunal to assess the facts in the main proceedings in the light of that guidance. (Operative part in 2).



Radetzky-Orden

(genuine use)

**CJEU 9 December 2008, case C-442/07, Verein Radetzky-Orden/
Bundesvereinigung Kameradschaft Feldmarschall Radetzky**

Article 12(1) Trade Mark Directive

A trade mark is put to genuine use where a non-profit-making association uses the trade mark not merely for internal use, but also, for example, in its relations with the public, in announcements of forthcoming events, on business papers and on advertising material and where the association's members wear badges featuring that trade mark when collecting and distributing donations.

Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky' is the proprietor of figurative- and word marks representing essentially badges of honor. Several members wear those badges at meetings and when they are collecting and distributing donations. The trade mark is also used on announcements and business papers.

The fact that a charitable association does not seek to make profit does not mean that its objective cannot be to create and, later, to preserve an outlet for its goods or services. (Para. 17).

In addition, paid welfare services exist. In modern society, various types of non-profit-making association have sprung up which, at first sight, offer their services free but which, in reality, are financed through subsidies or receive payment in various. (Para. 18).

It cannot be ruled out, therefore, that trademarks registered by a non-profit-making association may have a *raison d'être*, in that they protect the association against the possible use in business of identical or similar signs by third persons. (Para. 19).

Use of a trade mark by a non-profit-making association during purely private ceremonies or events, or for the advertisement or announcement of such ceremonies or events, constitutes an internal use of the trade mark and not 'genuine use' for the purposes of Article 12(1) of the directive. (Para. 22).

Article 12(1) of the Directive is to be construed as meaning that a trade mark is put to genuine use where a non-profit-making association uses the trade mark, in its relations with the public, in announcements of forthcoming events, on business papers and on advertising material and where the association's members wear badges featuring that trade mark when collecting and distributing donations. (Operative part).

Silberquelle/Maselli-Strickmode

(genuine use)

CJEU 15 January 2009, case C-495/07, Silberquelle/Maselli-Strickmode GmbH

Articles 10 and 12 Trade Mark Directive

Where the proprietor of a mark affixes that mark to items that it hands out as a gift, to purchasers of its goods, it does not make genuine use of that mark in respect of the class covering those items.

In the context of the sale of its clothing, Maselli used its mark to designate an alcohol-free drink which was handed out as a gift in bottles marked 'WELLNESS-DRINK'.

As the Commission submitted in its observations to the Court and as the Advocate General stated in points 45 and 55 of his Opinion, it is essential, in the light of the number of marks that are registered and the conflicts that are likely to arise between them, to maintain the rights conferred by a mark for a given class of goods or services only where that mark has been used on the market for goods or services belonging to that class. (Para. 19).

For the reasons set out in points 48 and 56 of that Opinion, that condition is not fulfilled where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter. (Para. 20).

In such a situation, those items are not distributed in any way with the aim of penetrating the market for goods in the same class. In those circumstances, affixing the mark to those items does not contribute to creating an outlet for those items or to distinguishing, in the interest of the customer, those items from the goods of other undertakings. (Para. 21).

In the light of the foregoing considerations, the answer to the question referred is that Articles 10(1) and 12(1) of the directive must be interpreted as meaning that, where the proprietor of a mark affixes that mark to items that it gives, free of charge, to purchasers of its goods, it does not make genuine use of that mark in respect of the class covering those items. (Para. 22).

Onel/Omel

(territorial scope of use)

**CJEU 19 December 2012, case C-149/11, Leno/Hagelkruis;
Onel/Omel**

Article 15 Trade Mark Regulation

In the assessment of whether a trade mark has been put to 'genuine use', territorial borders should be disregarded. Under circumstances it is not excluded that use in a single country can constitute genuine use of a Community trade mark.

Leno opposes the registration of the trade mark OMEL by Hagelkruis on the basis of its earlier trade mark ONEL. Hagelkruis disputes that the trade mark ONEL has been put to genuine use in the European Union for classes 35, 41 and 42. Hagelkruis acknowledges that Leno has genuinely used the trade mark in the Netherlands.

The 'territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community'. (Operative part 1).

'Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.' (Para. 50).

'A Community trade mark is put to 'genuine use' when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity. (Operative part 2).

OTHER CASES ON GENUINE USE

CJEU 25 October 2012, case C-553/11, Bernhard Rintisch/Klaus Eder; Proti

Rintisch is the proprietor of the word marks PROTIPLUS and PROTI en the word/figurative mark Proti Power for protein based goods. He opposes the use of the later word mark Protifit by Eder. Eder claims that Rintisch has not put the word mark PROTI to genuine use. He only uses the trade marks PROTIPLUS and Proti Power. The ECJ holds: Article 10(2)(a) Trade Mark Directive 'must be interpreted as meaning that the proprietor of a registered trade mark is not precluded from relying, in order to establish use of the trade mark for the purposes of that provision, on the fact that it is used in a form which differs from the form in which it was registered, without the differences between the two forms altering the distinctive character of that trade mark, even though that different form is itself registered as a trade mark.' (Operative part 1).

Article 10(2)(a) Trade Mark Directive 'be interpreted as precluding an interpretation of the national provision intended to transpose it into domestic law whereby Article 10(2)(a) does not apply to a 'defensive' trade mark which is registered only in order to secure or expand the protection of another registered trade mark that is registered in the form in which it is used.' (Operative part 2).



CJEU 18 April 2013, case C-12/12, Colloseum/Levi Strauss

Levi Strauss is proprietor of the trade mark which is a position mark and consists of a rectangular red label, made of textile, sewn into and protruding from the upper part of the left-hand seam of the rear pocket of trousers, shorts or skirts. The question is if the trade mark had been put to genuine use.

'The condition of genuine use of a trade mark [...] may be satisfied where a registered trade mark, which has become distinctive as a result of the use of another composite mark of which it constitutes one of the elements, is used only through that other composite mark, or where it is used only in conjunction with another mark, and the combination of those two marks is, furthermore, itself registered as a trade mark.' (Operative part).



CJEU 18 July 2013, case C-252/12, Specsavers/Asda

The condition of 'genuine use', within the meaning of those provisions, may be fulfilled where a Community figurative mark is used only in conjunction with a Community word mark which is superimposed over it, and the combination of those two marks is, furthermore, itself registered as a Community trade mark, to the extent that the differences between the form in which that trade mark is used and that in which it was registered do not change the distinctive character of that trade mark as registered. (Operative part 1).

Lindt & Sprüngli/ Frans Hauswirth

CJEU 11 June 2009, case C-529/07, Lindt & Sprüngli/Frans Hauswirth

Article 51(1)(b) (old, now article 52 (1)(b)) Trade Mark Regulation



Lindt & Sprüngli is proprietor of a figurative mark consisting a sitting golden chocolate bunny, with a red ribbon, a little bell and brown lettered words „Lindt GOLDHASE“. Based on the foregoing, Lindt & Sprüngli object to another chocolate bunny of Frans Hauswirth (see picture).

For the assessment of bad faith of a trademark application, the knowledge that a third party is using an identical or similar sign, with the intention to prevent that third party from continuing to use such a sign and the degree of legal protection enjoyed by the sign, must be taken into consideration.

The intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market. In such a case, the mark does not fulfill its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion. (Para. 42-45).

Equally, the fact that a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for and that that sign enjoys some degree of legal protection is one of the factors relevant to the determination of whether the applicant was acting in bad faith. In such a case, the applicant's sole aim in taking advantage of the rights conferred by the Community trade mark might be to compete unfairly with a competitor who is using a sign which, because of characteristics of its own, has by that time obtained some degree of legal protection. (Para. 46-47).

In order to determine whether the applicant is acting in bad faith within the meaning of Article 51(1)(b) of [the Trade Marks Regulation], the national court must take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration of the sign as a Community trade mark, in particular:

- the fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought;
- the applicant's intention to prevent that third party from continuing to use such a sign; and
- the degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought. (Para. 53).



Malaysia Dairy

(bad faith)

CJEU 27 June 2013, case C-320/12, Malaysia Dairy/Ankenævnet for Patenter og Varemærker; Yakult

Article 4(4)(g) Trade Mark Directive

Knowledge of a foreign mark in use is insufficient to establish 'bad faith'.

Since 1965 Yakult owns the design and trade mark rights on a plastic bottle for a milk drink in Japan and several other countries. Since 1977 Malaysia Dairy produced and marketed a milk drink in a plastic bottle. In 1980 Malaysia Dairy obtained a registration on the similar plastic bottle, i.a. in Malaysia. Yakult claims that Malaysia Dairy acted in bad faith when applying for registration of a trade mark for the plastic bottle in Denmark.

The concept of 'bad faith', within the meaning of that provision, is an autonomous concept of European Union law which must be given a uniform interpretation in the European Union. (Operative part 1).

'In order to permit the conclusion that the person making the application for registration of a trade mark is acting in bad faith within the meaning of that provision, it is necessary to take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration. The fact that the person making that application knows or should know that a third party is using a mark abroad at the time of filing his application which is liable to be confused with the mark whose registration has been applied for is not sufficient, in itself, to permit the conclusion that the person making that application is acting in bad faith within the meaning of that provision.' (Operative part 2).

'Article 4(4)(g) of the Trade Mark Directive must be interpreted as meaning that it does not allow Member States to introduce a system of specific protection of foreign marks which differs from the system established by that provision and which is based on the fact that the person making the application for registration of a mark knew or should have known of a foreign mark.' (Operative part 3).



Björnekulla sought revocation in Sweden of the trade mark Bostongurka of Procordia, because it had become a generic name in Swedish for chopped pickled gherkins.

Bostongurka

(perception of the end user)

CJEU 29 April 2004, case C-371/02, Björnekulla/Procordia; Bostongurka

Article 12(2) Trade Mark Directive

In determining whether a mark has become generic, the perception of the end user is of primary importance, but the perception of all those in the trade who deal with that product commercially may also be relevant.

‘In general, the perception of consumers or end users will play a decisive role. The whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it. (Para. 24).

Accordingly, the relevant classes of persons comprise principally consumers and end users. However, depending on the features of the product market concerned, the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration.’ (Para. 25).

‘Article 12(2)(a) of the First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks should be interpreted as meaning that in cases where intermediaries participate in the distribution to the consumer or the end user of a product which is the subject of a registered trade mark, the relevant classes of persons whose views fall to be taken into account in determining whether that trade mark has become the common name in the trade for the product in question comprise all consumers and end users and, depending on the features of the market concerned, all those in the trade who deal with that product commercially.’ (Operative part).

Levi Strauss/Casucci

(loss of distinctiveness)

CJEU 27 April 2006, case C-145/05, Levi Strauss/Casucci; overstitching

Article 5(1)(b) Trade Mark Directive

Article 12(2) Trade Mark Directive



Levi Strauss is the proprietor of a graphic mark known as ‘mouette’ (seagull), a design represented by a double row of overstitching curving downwards in the middle, placed in the centre of a pentagonal pocket and objected to jeans put on the market by Casucci bearing a sign comprising a double row of overstitching, curving upwards in the centre of the back pockets. The lower courts were of the opinion that this kind of stitching had become generic.

‘Article 5(1) [Trade Mark Directive] [...] must be interpreted as meaning that, in order to determine the scope of protection of a trade mark which has been lawfully acquired on the basis of its distinctive character, the national court must take into account the perception of the public concerned at the time when the sign, the use of which infringes that trade mark, began to be used.

Where the competent national court finds that the sign in question constituted an infringement of the mark at the time when the sign began to be used, it is for that court to take such measures as prove to be the most appropriate in the light of the circumstances of the case in order to safeguard the proprietor’s rights deriving from Article 5(1) [Trade Mark Directive]; such measures may include, in particular, an order to cease use of that sign.

It is not appropriate to order cessation of the use of the sign in question if it has been established that the trade mark has lost its distinctive character, in consequence of acts or inactivity of the proprietor, so that it has become a common name within the meaning of Article 12(2) [Trade Mark Directive], and the trade mark has therefore been revoked.’ (Operative part).

Robelco/Robeco

(use as trade name)

CJEU 21 November 2002, case C-23/01, Robelco/Robeco

Article 5(5) Trade Mark Directive

A Member State may, if it sees fit, and subject to such conditions as it may determine, protect a trade mark against use of a sign other than for the purpose of distinguishing goods or services.

Trade mark owner Robeco objected in Belgium to the use of the trade name Robelco.

‘Article 5(5) of [Trade Mark Directive] [...] must be interpreted as meaning that a Member State may, if it sees fit, and subject to such conditions as it may determine, protect a trade mark against use of a sign other than for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.’ (Operative part).

‘Accordingly, where, as in the main proceedings, the sign is not used for the purposes of distinguishing goods or services, it is necessary to refer to the legal orders of the Member States to determine the extent and nature, if any, of the protection afforded to owners of trade marks who claim to be suffering damage as a result of use of that sign as a trade name or company name. (Para. 34).

The Member States may adopt no legislation in this area or they may, subject to such conditions as they may determine, require that the sign and the trade mark be either identical or similar, or that there be some other connection between them.’ (Para. 35).

DHL/Chronopost

(territorial scope)

CJEU 12 April 2011, case C-235/09, DHL/Chronopost

Articles 1, 9 and 14 Trade Mark Regulation

A prohibition against further infringement must be ensured in the entire area of the European Union, except if there is evidence that the sign at issue does not affect or is not liable to affect the functions of the trade mark, especially on linguistic grounds.

Based on their Community Trade Mark "WEBSHIPPING", Chronopost objects to the use of the description 'web shipping' by DHL in order to designate an express mail management service accessible on the Internet.

In order to ensure that uniform protection, a prohibition against further infringement or threatened infringement issued by a competent Community trade mark court must therefore, as a rule, extend to the entire area of the European Union. (Para. 44, Operative part in 1).

However, the territorial scope of the prohibition may, in certain circumstances, be restricted. The exclusive right of a Community trade mark proprietor is conferred in order to enable that proprietor to protect his specific interests as such, that is, to ensure that the trade mark is able to fulfill its functions. The exercise of that right must therefore be reserved to cases in which a third party's use of the sign affects or is liable to affect the functions of the trade mark. It follows that the exclusive right of a Community trade mark proprietor and, hence, the territorial scope of that right, may not extend beyond what that right allows its proprietor to do in order to protect his trade mark, that is, to prohibit only uses which are liable to affect the functions of the trade mark. The acts or future acts of a defendant which do not affect the functions of the Community trade mark, cannot therefore be prohibited. (Para. 46 and 47).

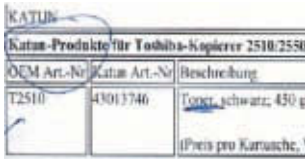
If a Community trade mark court hearing a case in circumstances such as those of the main proceedings finds that the acts of infringement or threatened infringement of a Community trade mark are limited to a single Member State or to part of the territory of the European Union, in particular because the applicant for a prohibition order has restricted the territorial scope of its action in exercising its freedom to determine the extent of that action or because the defendant proves that the use of the sign at issue does not affect or is not liable to affect the functions of the trade mark, for example on linguistic grounds, that court must limit the territorial scope of the prohibition which it issues. (Para. 48).

Toshiba/Katun

(reference to product numbers)

CJEU 25 October 2001, case C-112/99, Toshiba/Katun; OEM-numbers

Articles 3a and 7 Comparative Advertising Directive¹



OEM Art.-Nr.	Katan Art.-Nr.	Beschreibung
T2510	43013746	Toner, schwarz; 450 g

(Preis pro Kartusche,)

Katun sells spare parts (i.a.) for Toshiba photocopiers. In its catalogues it states its products next to OEM (Original Equipment Manufacturer) – numbers of Toshiba. Toshiba objects to this.

Use of product numbers of competitor in a catalogue of spare parts is allowed.

1. On a proper construction of Articles 2(2a) and 3a(1)(c) [Comparative Advertising Directive], the indication, in the catalogue of a supplier of spare parts and consumable items suitable for the products of an equipment manufacturer, of product numbers (OEM numbers) by which the equipment manufacturer designates the spare parts and consumable items which he himself sells may constitute comparative advertising which objectively compares one or more material, relevant, verifiable and representative features of goods.
2. On a proper construction of Article 3a(1)(g) [Comparative Advertising Directive], where product numbers (OEM numbers) of an equipment manufacturer are, as such, distinguishing marks within the meaning of that provision, their use in the catalogues of a competing supplier enables him to take unfair advantage of the reputation attached to those marks only if the effect of the reference to them is to create, in the mind of the persons at whom the advertising is directed, an association between the manufacturer whose products are identified and the competing supplier, in that those persons associate the reputation of the manufacturer's products with the products of the competing supplier. In order to determine whether that condition is satisfied, account should be taken of the overall presentation of the advertising at issue and the type of persons for whom the advertising is intended.' (Operative part).

¹ Council Directive 84/450/EEC of 10 September 1984 concerning misleading and comparative advertising, as amended by Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997.

Pippig/Hartlauer

(use of a competitor's logo)



CJEU 8 April 2003, case C-44/01, Pippig/Hartlauer

Articles 3a and 7 Comparative Advertising Directive

Comparative advertising by showing the logo or shop-front of a competitor is allowed in principle.

The optician chain Hartlauer compared in a leaflet and in a television commercial the prices of traditional opticians, including Pippig, with its own prices. In the television commercial the shop-front with logo of Pippig was visible.

1. Article 7(2) [Comparative Advertising Directive], precludes the application to comparative advertising of stricter national provisions on protection against misleading advertising as far as the form and content of the comparison is concerned, without there being any need to establish distinctions between the various elements of the comparison, that is to say statements concerning the advertiser's offer, statements concerning the competitor's offer and the relationship between those offers.
2. Article 3a(1)(a) [Comparative Advertising Directive], must be interpreted as meaning that, whereas the advertiser is in principle free to state or not to state the brand name of rival products in comparative advertising, it is for the national court to verify whether, in particular circumstances, characterised by the importance of the brand in the buyer's choice and by a major difference between the respective brand names of the compared products in terms of how well known they are, omission of the better-known brand name is capable of being misleading.
3. Article 3a(1) [Comparative Advertising Directive], as amended, does not preclude compared products from being purchased through different distribution channels.
4. Article 3a(1) [Comparative Advertising Directive], as amended, does not preclude an advertiser from carrying out a test purchase with a competitor before his own offer has even commenced, where the conditions for the lawfulness of comparative advertising set out therein are complied with.
5. A price comparison does not entail the discrediting of a competitor, within the meaning of Article 3a(1)(e) [Comparative Advertising Directive], either on the grounds that the difference in price between the products compared is greater than the average price difference or by reason of the number of comparisons made. Article 3a(1)(e) [Comparative Advertising Directive], does not prevent comparative advertising, in addition to citing the competitor's name, from reproducing its logo and a picture of its shop front, if that advertising complies with the conditions for lawfulness laid down by Community law.' (Operative part).

Siemens/Vipa

(use of identical order numbers)

CJEU 23 February 2006, case C-59/05, Siemens/VIPA

Article 3a(1)(g) Comparative Advertising Directive

In this case, the competing supplier does not take unfair advantage of the reputation of that distinguishing mark by using partly identical order numbers.

VIPA uses order numbers which are partly identical to the order numbers of the products of Siemens which they are compatible with. Siemens objects to this.

VIPA sells components which are compatible with the 'Sematic' control systems of Siemens, for which it uses an identification system which is almost identical to the one of Siemens. The first part of the character combination in the order numbers of Siemens is replaced by the word 'VIPA' followed by the core element of the order number of the original product of Siemens. This order number refers to characteristics of the product of Siemens in question and to the use thereof in the computer platform; this number must be entered into this platform to activate the control.

Comparative advertising intends to allow consumers to take as much advantage of the internal market as possible, since advertising is an important tool to create real outlets everywhere in the Community for all goods and services. Comparative advertising also has the purpose to create an incentive for competition between suppliers of goods and services in the interest of consumers.

'In the present case, if a different core element were to be used for the order numbers of goods distributed by VIPA and intended for use with Siemens controllers as add-on components, the users concerned would be required to look in comparative listings for the order numbers corresponding with the goods sold by Siemens. That would be disadvantageous, as the national court pointed out, to consumers and to VIPA. The possibility that there would be restrictive effects on competition in the market for add-on components to the controllers manufactured by Siemens cannot therefore be excluded.' (Para. 26).

'Article 3a(1)(g) [Comparative Advertising Directive], must be interpreted as meaning that, in circumstances such as those in the main proceedings, by using in its catalogues the core element of a manufacturer's distinguishing mark which is known in specialist circles, a competing supplier does not take unfair advantage of the reputation of that distinguishing mark.' (Operative part).



Lidl/Colruyt

(comparative advertising relating to the prices of a products selection)

CJEU 19 September 2006, case C-356/04, Lidl/Colruyt

Article 3a(1)(c) Comparative Advertising Directive

Comparative advertising relating to the prices of a products selection is allowed, as long as it is not misleading.

Colruyt had a comparative advertisement relating to the prices of a products selection. According to Lidl this advertisement was not objective, not verifiable and misleading.

The condition under which comparative advertising is permissible that is laid down by Article 3a(1)(b) of the [Comparative Advertising Directive] must be interpreted as not precluding comparative advertising from relating collectively to selections of basic consumables sold by two competing chains of stores in so far as those selections each consist of individual products which, when viewed in pairs, individually satisfy the requirement of comparability laid down by that provision. (Operative part in 1).

The requirement, laid down by Article 3a(1)(c) of the Directive, that the advertising 'objectively compares' the features of the goods at issue must be interpreted as not signifying, in the event of comparison of the prices of a selection of comparable basic consumables sold by competing chains of stores or of the general level of the prices charged by them in respect of the range of comparable products which they sell, that the products and prices compared, that is to say both those of the advertiser and those of all of his competitors involved in the comparison, must be expressly and exhaustively listed in the advertisement. (Operative part in 2).

Article 3a(1)(c) of the Directive must be interpreted as meaning that the following constitute, for the purposes of that provision, 'verifiable' features of goods sold by two competing chains of stores:

- the prices of those goods;
- the general level of the respective prices charged by such chains of stores in respect of their selection of comparable products and the amount liable to be saved by consumers who purchase such products from one rather than the other of those chains, in so far as the goods in question do in fact form part of the selection of comparable products on whose basis that general price level has been determined. (Operative part in 3).

Article 3a(1)(c) of the Directive must be interpreted as meaning that a feature mentioned in comparative advertising satisfies the requirement of verifiability laid down by that provision, in cases where the details of the comparison which form the basis for the mention of that feature are not set out in the advertising, only if the advertiser indicates, in particular for the attention of the persons to whom the advertisement is addressed, where and how they may readily examine those details

with a view to verifying, or, if they do not possess the skill required for that purpose, to having verified, the details and the feature in question as to their accuracy. (Operative part in 4).

Article 3a(1)(a) of Directive 84/450, as amended by Directive 97/55, must be interpreted as meaning that comparative advertising claiming that the advertiser's general price level is lower than his main competitors', where the comparison has related to a sample of products, may be misleading when the advertisement:

- does not reveal that the comparison related only to such a sample and not to all the advertiser's products,
- does not identify the details of the comparison made or inform the persons to whom it is addressed of the information source where such identification is possible, or
- contains a collective reference to a range of amounts that may be saved by consumers who make their purchases from the advertiser rather than from his competitors without specifying individually the general level of the prices charged, respectively, by each of those competitors and the amount that consumers are liable to save by making their purchases from the advertiser rather than from each of the competitors. (Operative part in 5).



O2 Holdings/ Hutchison 3G UK

(comparative Advertisement)

CJEU 12 June 2008, case C-533/06, O2 Holdings/Hutchison 3G UK

Article 5(1) Trade Mark Directive; Article 3a(1) Comparative Advertising Directive

The proprietor of a registered trade mark is not entitled to prevent the use of a mark which is identical or similar to its own trademark in comparative advertising, if the advertisement satisfies all the conditions laid down in the Comparative Advertising Directive, under which comparative advertising is permitted.

O2 objects to the use of its 'bubbles trade mark' in a comparative advertisement of Hutchison.

Article 5(1) and (2) of [the Trade Mark Directive] and Article 3a(1) of [the Comparative Advertising Directive] must be interpreted as meaning that the proprietor of a registered trade mark is not entitled to prevent the use by a third party of a sign identical with, or similar to, his mark, in a comparative advertisement which satisfies all the conditions, laid down in Article 3a(1) of [the Comparative Advertising Directive], under which comparative advertising is permitted. (Para. 51).

Where the conditions required under Article 5(1)(b) of [Trade Mark Directive] to prevent the use of a sign identical with, or similar to, a registered mark are met, a comparative advertisement in which that sign is used cannot satisfy the condition, laid down in Article 3a(1)(d) of [Comparative Advertising Directive], under which comparative advertising is permitted. (Para. 46).

Thus, in the case where an advertiser uses, in a comparative advertisement, a sign identical with, or similar to, a competitor's mark, the competitor either does not establish the existence of a likelihood of confusion and, consequently, is not entitled to prevent the use of that sign on the basis of Article 5(1)(b) of Directive 89/104, or he establishes the existence of a likelihood of confusion and, consequently, the advertiser cannot challenge such prevention under Article 3a(1) of Directive 84/450, since the advertisement at issue does not satisfy all the conditions laid down in that provision. (Operative Part).



Lidl/Vierzon

(comparison of price)

CJEU 18 November 2010, case C-159/09, Lidl/Vierzon

Article 3a(1)(a), (b) and (c) Comparative Advertising Directive

In a comparison of price based on a selection of products, the products compared do not need to be exactly the same.

Lidl objects to a price based comparison of a selection of food products by Vierzon.

Article 3a(1)(b) ‘The fact alone that food products differ in terms of the extent to which consumers would like to eat them and the pleasure to be derived from consuming them, according to the conditions and place of production, their ingredients and who produced them, cannot preclude the possibility that the comparison of such products may meet the requirement laid down in that provision that the products compared meet the same needs or are intended for the same purpose, that is to say, that they display a sufficient degree of interchangeability.’ (Para. 39).

Article 3a(1)(a) ‘An advertisement may be misleading, in particular if:

- it is found, in the light of all the relevant circumstances of the particular case, in particular the information contained in or omitted from the advertisement, that the decision to buy on the part of a significant number of consumers to whom the advertisement is addressed may be made in the mistaken belief that the selection of goods made by the advertiser is representative of the general level of his prices as compared with those charged by his competitor and that such consumers will therefore make savings of the kind claimed by the advertisement by regularly buying their everyday consumer goods from the advertiser rather than the competitor, or in the mistaken belief that all of the advertiser’s products are cheaper than those of his competitor, or
- it is found that, for the purposes of a comparison based solely on price, food products were selected which, nevertheless, have different features capable of significantly affecting the average consumer’s choice, without such differences being apparent from the advertising concerned.’ (Para. 56).

Article 3a(1)(c) ‘The condition of verifiability set out in that provision requires, in the case of an advertisement, such as that at issue in the main proceedings, which compares the prices of two selections of goods, that it must be possible to identify the goods in question on the basis of information contained in the advertisement.’ (Para. 64).

Gut Springenheide

(average consumer)

CJEU 16 July 1998, case C-210/96, Gut Springenheide/Steinfurt

Regulation concerning specific trade standards for eggs



Gut Springenheide markets under the designation '6-Korn – 10 frische Eier' pre-packed eggs. The fodder of the chickens consisted only for 60% of six types of cereals. According to the Oberkreisdirektor des Kreises Steinfurt – Amt für Lebensmittelüberwachung, this was misleading.

Article 10(2)(e) of Regulation (EEC) no. 1907/90 of the Council of 26 June concerning specific trade standards for eggs (OJ L 173, p. 5) provides that several additional statements on the packaging of eggs should not mislead.

According to the German court judging the facts 'a non-negligible part of the public could be misled by the designation "6-Korn – 10 frische Eier" which is also a trade mark and by the enclosed information leaflet, since it is wrongfully suggested that the fodder of the chickens exclusively consists of six types of cereal and that the eggs have special qualities'.

As appears from previous decisions concerning possible misleading nature of a denomination, mark or advertising statement, the CJEU started in its examination whether the denomination, the mark or the advertising statement could mislead the buyer from the presumed expectations of an average consumer who is reasonably well-informed and reasonably observant and circumspect. In previous decisions the Court not order any expert opinions or surveys.

'In order to determine whether a statement intended to promote sales of eggs is liable to mislead the purchaser, in breach of Article 10(2)(e) of Regulation (EEC) No 1907/90 of 26 June 1990 on certain marketing standards for eggs, the national court must take into account the presumed expectations which it evokes in an average consumer who is reasonably well-informed and reasonably observant and circumspect. However, Community law does not preclude the possibility that, where the national court has particular difficulty in assessing the misleading nature of the statement or description in question, it may have recourse, under the conditions laid down by its own national law, to a consumer research poll or an expert's report as guidance for its judgment.' (Operative part).

'In the absence of any Community provision on this point, it is for the national court, which may find it necessary to order such a survey, to determine, in accordance with its own national law, the percentage of consumers misled by a promotional description or statement that, in its view, would be sufficiently significant in order to justify, where appropriate, banning its use.' (Para. 36).

As to the question of confusion under trade mark law this criterion was adopted in the Lloyd/Loint case.

Philips and Nokia

(no manufacturing fiction in case of transit)

**CJEU 1 December 2011, cases C-446/09 and C-495/09,
Philips and Nokia**

Customs regulation no 1383/2003

Counterfeit goods cannot be seized by the customs on the fiction that those goods are deemed to have been manufactured in that Member State, when those goods are destined for another market than the European Union market.

Customs had seized pirated shavers and mobile phones made by Nokia resp. Philips, which were destined for transit outside the EU.

Goods coming from a non-member State which are imitations of goods protected in the European Union by a trade mark right or copies of goods protected in the European Union by copyright, a related right or a design cannot be classified as ‘counterfeit goods’ or ‘pirated goods’ within the meaning of those regulations merely on the basis of the fact that they are brought into the customs territory of the European Union under a suspensive procedure;

Those goods may, on the other hand, infringe the right in question and therefore be classified as ‘counterfeit goods’ or ‘pirated goods’ where it is proven that they are intended to be put on sale in the European Union, such proof being provided, inter alia, where it turns out that the goods have been sold to a customer in the European Union or offered for sale or advertised to consumers in the European Union, or where it is apparent from documents or correspondence concerning the goods that their diversion to European Union consumers is envisaged;

In order that the authority competent to take a substantive decision may profitably examine whether such proof and the other elements constituting an infringement of the intellectual property right relied upon exist, the customs authority to which an application for action is made must, as soon as there are indications before it giving grounds for suspecting that such an infringement exists, suspend the release of or detain those goods,

Those indications may include, inter alia, the fact that the destination of the goods is not declared whereas the suspensive procedure requested requires such a declaration, the lack of precise or reliable information as to the identity or address of the manufacturer or consignor of the goods, a lack of cooperation with the customs authorities or the discovery of documents or correspondence concerning the goods in question suggesting that there is liable to be a diversion of those goods to European Union consumers. (Operative part).

Hermès/FHT

(provisional measures)

CJEU 16 June 1998, case C-53/96, Hermès/FHT

Article 50(6) TRIPs



Provisional measures given in summary proceedings ('kort geding') should be followed by full court proceedings ('bodemprocedure').

Hermès obtained successfully a provisional measure against FHT as to the marketing of infringing ties.

See further, for answers to various detail questions as to the (direct effect) of article 50(6): CJEU 13 September 2001, case C-89-99, Schieving-Nijstad/Groeneveld; Route 66 (not included) IER 2001/59. Article 50(6) TRIPs has been implemented in article 1019(i) Dutch Code of Civil Procedure.

On the ground of article 50(6) TRIPs, upon request of the defendant, provisional measures will be revoked or otherwise cease to have effect, if proceedings leading to a decision on the merits of the case are not initiated within a reasonable period, to be determined by the judicial authority ordering the measures where a Member's law so permits or, in the absence of such a determination, not to exceed 20 working days or 31 calendar days, whichever is the longer.

'A measure whose purpose is to put an end to alleged infringements of a trade-mark right and which is adopted in the course of a procedure distinguished by the following features:

- the measure is characterised under national law as an 'immediate provisional measure' and its adoption must be required 'on grounds of urgency',
- the opposing party is summoned and is heard if he appears before the court,
- the decision adopting the measure is reasoned and given in writing following an assessment of the substance of the case by the judge hearing the interim application,
- an appeal may be lodged against the decision, and
- although the parties remain free to initiate proceedings on the merits of the case, the decision is usually accepted by the parties as a 'final' resolution of their dispute, is to be regarded as a 'provisional measure' within the meaning of Article 50 of the TRIPs Agreement' (Operative part).



Budweiser

(trade mark vs trade name under TRIPs)

**CJEU 16 November 2004, case C-245/02, Anheuser Busch/
Budějovický Budvar; Budweiser**

Articles 16 and 17 TRIPs.

A trade name may constitute a sign within the meaning of Article 16 TRIPs. A later trade mark cannot oppose an earlier trade name.

On the basis of its trade mark 'Budweiser', Anheuser Busch objected to the use of the trade name 'Budweiser Budvar' by Budějovický Budvar.

1. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs Agreement) [...], applies in the event of a conflict between a trade mark and a sign alleged to infringe that trade mark where that conflict arose before the date of application of the TRIPs Agreement but continued beyond that date.
2. A trade name may constitute a sign within the meaning of the first sentence of Article 16(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs Agreement). That provision is intended to confer on the proprietor of a trade mark the exclusive right to prevent a third party from using such a sign if the use in question prejudices or is liable to prejudice the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods.

The exceptions provided for in Article 17 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs Agreement) are intended, inter alia, to enable a third party to use a sign which is identical or similar to a trade mark to indicate his trade name, provided that such use is in accordance with honest practices in industrial or commercial matters.

3. A trade name which is not registered or established by use in the Member State in which the trade mark is registered and in which protection against the trade name in question is sought may be regarded as an existing prior right within the meaning of the third sentence of Article 16(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs Agreement) if the proprietor of the trade name has a right falling within the substantive and temporal scope of that agreement which arose prior to the trade mark with which it is alleged to conflict and which entitles him to use a sign identical or similar to that trade mark..’ (Operative part).

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CJEU 18 June 2002, case C-299/99, Philips/Remington; three-headed shaver
- 28 Benetton Group/G-Star International (substantial value)
CJEU 20 September 2007, C-371/06, Benetton Group/G-Star; Elwood trousers
- 29 Lego/OHIM (technical solution)
CJEU 14 September 2010, C-48/09 P, Lego/OHIM
- 30 Freixenet Bottle
CJEU 20 October 2011, C-344/10 P en C-345/10, Freixenet/OHIM

Other cases concerning shape marks

- 31 CJEU 29 April 2004, cases C-456/01 P, C-457/01 P and C-468/01 P t/m C-472/01 P, Henkel and P&G/OHIM; dishwasher tablets
- 31 CJEU 7 October 2004, case C-136/02 P, Maglite/OHIM; flashlight
- 31 CJEU 30 June 2005, C-286/04 P, Eurocermex/OHIM; Corona beer bottle
- 31 CJEU 12 January 2006, C-173/04 P, SiSi/OHIM; standing pouches
- 31 CJEU 24 May 2012, C-98/11 P, Lindt & Sprüngli/OHIM
- 32 CFI 5 March 2003, case T-128/01, DaimlerChrysler/OHIM; Jeep-grille
- 32 CFI 3 December 2003, case T-305/02, Nestlé/OHIM; shape of a water bottle
- 32 CFI 24 November 2004, case T-393/02, Henkel/OHIM; shape of a white and transparent bottle

ABSOLUTE GROUNDS FOR REFUSAL (COLOUR, SMELL AND SOUND)

- 33 Libertel (colour marks, general interest)
CJEU 6 May 2003, case C-104/01, Libertel/BMB; colour orange
- 34 Heidelberger Bauchemie (colour combinations)
CJEU 24 June 2004, case C-49/02, Heidelberger Bauchemie; blue and yellow
- 35 Sieckmann (smell marks)
CJEU 12 December 2002, case C-273/00, Sieckmann/DPM; smell mark
- 36 Shield Mark (sound marks)
CJEU 27 November 2003, case C-283/01, Shield Mark/BMB; sound marks

Other cases on refusal on absolute grounds

- 37 CJEU 28 June 2004, case C-445/02, Glaverbel/OHIM; surface of glass
- 37 CJEU 21 October 2004, case C-447/02, KWS/Saat/OHIM; colour orange
- 37 CJEU 7 July 2005, case C-418/02, Praktiker Märkte/DPMA; retail trade services
- 38 CJEU 30 March 2006, case C-259/04, Elizabeth Emanuel/Continental Shelf 128; Elizabeth Emanuel
- 38 CJEU 5 July 2011, C-263/09 P, Edwin Co. Ltd/ OHIM & Elio Fiorucci
- 38 CJEU 19 June 2012, C-307/10, Patent Attorneys /Registrar of Trade Marks; IP Translator

INFRINGEMENT (RISK OF CONFUSION)

- 40 Arthur & Félicie (sign identical to mark)
CJEU 20 March 2003, case C-291/00, LTJ Diffusion/Sadas; Arthur (& Félicie)
- 41 Adam Opel/Autec (scale model)
CJEU 25 January 2007, C-48/05, Adam Opel/Autec
- 42 Puma/Sabel (confusion and association)
CJEU 11 November 1997, case C-251/95, Puma/Sabel; bounding feline
- 43 Canon/Cannon (similarity and reputation)
CJEU 29 September 1998, case C-39/97, Canon/Metro-Goldwyn-Mayer; Canon/Cannon
- 44 Lloyd/Loint's (confusion and aural similarity)
CJEU 22 June 1999, case C-342/97, Lloyd/Klijssen; Lloyd/Loint's
- 45 Picasso/Picaro (likelihood of confusion)
CJEU 12 January 2006, case C-361/04, The Picasso estate/DaimlerChrysler; Picasso/Picaro
- 46 Obelix/Mobilix (confusion and aural similarity)
CJEU 18 December 2008, C-16/06 P, Les Éditions Albert René/Orange A/S; Obelix/Mobilix
- 47 Il Ponte Finanziaria/ FMG Textiles (series of trade marks)
CJEU 13 September 2007, C-234/06, Il Ponte Finanziaria/ FMG Textiles
- 48 OHIM/Shaker; Limoncello
CJEU 12 June 2007, C-334/05 P, OHIM/Shaker; Limoncello
- 50 Carbonell/La Española (likelihood of confusion of figurative trademarks)
CJEU 3 September 2009, C-498/07 P, Aceites del Sur/Koipe; Carbonell/ La Española Ferrero/OHIM (similarity)
- 51 Ferrero/OHIM; Kinder (similarity)
CJEU 24 March 2011, C-552/09 P, Ferrero/OHIM; Kinder

- 52 Calvin Klein
CJEU 2 September 2010, C-254/09 P, Calvin Klein Trademark Trust/OHIM
- 53 Adidas/Marca II (infringement question)
CJEU 10 April 2008, C-102/07, Adidas/Marca II
- 54 Céline (use of trade name as trade mark)
CJEU 11 September 2007, C-17/06, Céline SARL/Céline SA
- 56 Montex/Diesel (transit)
CJEU 9 November 2006, C-281/05. Montex/Diesel

Other cases concerning confusion

- 57 CJEU 22 June 2000, case C-425/98, Marca/Adidas; three versus two stripes
- 57 CJEU 28 April 2004, case C-3/03 P, Matratzen Concord/OHIM-Hukla; Matratzen
- 57 CJEU 12 October 2004, case C-106/03 P, Verdial/OHIM; Saint-Hubert 41/Hubert
- 58 CJEU 6 October 2005, C-120/04, Medion/ Thomson; Life/Thomson Life
- 58 CJEU 1 December 2005, case C-512/04 P, Vitakraft/OHIM-Krafft; Krafft/Vitakraft
- 58 CJEU 23 March 2006, case C-206/04 P, Mülhens/OHIM en Zirh; Sir/Zirh
- 58 CJEU 27 April 2006, case C-235/05 P, L'Oréal v OHIM – Revlon; Flex/Flexi Air
- 59 CJEU 16 July 2011, C-317/10 P, Union Investment/UniCredito & OHIM
- 59 CJEU 24 May 2012, C-196/11 P, Formula One/OHIM; F1 word/device marks

INFRINGEMENT (WELL-KWOWN MARKS)

- 60 Chevy (reputation)
CJEU 14 September 1999, case C-375/97, General Motors/Yplon; Chevy
- 61 PAGO (reputation in the EU)
CJEU 6 October 2009, C-301/07, PAGO/Tirolmilch
- 62 Davidoff/Gofkid (dilution and similar goods)
CJEU 9 January 2003, case C-292/00, Davidoff/Gofkid; Davidoff/Durffee
- 63 Adidas/Fitnessworld (dilution and embellishment)
CJEU 23 October 2003, case C-408/01, Adidas/Fitnessworld Trading; three stripes versus two stripes
- 64 Intel (reputation and dilution)
CJEU 27 November 2008, C-252/07, Intel Corporation/CPM United Kingdom
- 66 L'Oréal/Bellure (taking unfair advantage of a well-known mark)
CJEU 18 June 2009, C-487/07, L'Oréal /Bellure

Other cases on reputation

- 68 CJEU 10 May 2012, C-100/11 P, Helena Rubinstein & L'Oréal/ OHIM & Allergan
- 69 HvJ EU 14 november 2013, zaak C-383/12 P, Environmental Manufacturing/BHIM & Société Elmar Wolf

INFRINGEMENT (INTERNET)

- 69 Google France (adwords)
CJEU 23 March 2010, C-236/08, C-237/08, C-238/08, Google France
- 71 L'Oréal/eBay (use of a trade mark on an online marketplace)
CJEU 12 July 2011, C-324/09, L'Oréal/eBay
- 73 Interflora/Marks & Spencer (adwords)
CJEU 22 September 2011, C-323/09, Interflora/Marks & Spencer

INFRINGEMENT (OTHER)

- 75 Winters/Red Bull (filling in order)
CJEU 15 December 2011, C-119/10, Winters/Red Bull
- 76 Specsavers/Asda (trade mark as used)
CJEU 18 July 2013, C-252/12, Specsavers/Asda

TRADE MARK LIMITATIONS

- 77 Dior/Evora (advertising by reseller)
CJEU 4 November 1997, case C-337/95, Dior/Evora
- 78 BMW/Deenik (non-official dealer)
CJEU 23 February 1999, case C-63/97, BMW/Ronald Deenik
- 79 Arsenal/Reed (badge of support)
CJEU 12 November 2002, case C-206/01, Arsenal/Matthew Reed
- 80 Gerri/Kerry spring (indication of geographical origin)
CJEU 7 January 2004, case C-100/02, Gerolsteiner Brunnen/Putsch; Gerry/Kerry
- 81 Gillette/ LA-Laboratories (indication of intended purpose)
CJEU 17 March 2005, C-228/03, Gillette/LA-Laboratories
- 82 Hölterhoff/Freiesleben (use to indicate characteristics)
CJEU 14 May 2002, case C- 2/00, Hölterhoff/Freiesleben; Spirit Sun & Context Cut
- 83 Portakabin/Primakabin (adwords and exhaustion)
CJEU 8 July 2010, C-558/08, Portakabin/Primakabin
- 85 Viking Gas/ Kosan Gas (refilling)
CJEU 14 July 2011, C-46/10, Viking Gas/Kosan Gas

PARALLEL TRADE

- 86 Silhouette/Hartlauer (European exhaustion)
CJEU 16 July 1998, case C-355/96, Silhouette/Hartlauer; Silhouette spectacles
- 87 Van Doren + Q/Lifestyle; Stüssy (burden of proof)
CJEU 8 April 2003, case C-244/00, Van Doren + Q/Lifestyle; Stüssy
- 88 Class International (in transit)
CJEU 18 October 2005, case C-405/03, Class/SmithKline Beecham; Aquafresh toothpaste
- 89 Makro/Diesel (consent)
CJEU 15 October 2009, C-324/08, Makro/Diesel
- 90 Copad/Dior (damage to the aura of luxury goods)
CJEU 23 April 2009, C-59/08, Copad/Dior
- 91 Coty/Simex (no exhaustion on perfume testers)
CJEU 3 June 2010, C-127/09, Coty/Simex

Other cases on parallel trade

- 92 CJEU 1 July 1999, case C-173/98, Sebago/G-B Unic; Docksides
- 92 CJEU 20 November 2001, cases C-414/99 and C-415/99, Zino Davidoff/A & G Imports, Levi Strauss/ Tesco and Costco; Cool water & Levi's
- 92 CJEU 30 November 2004, case C-16/03, Peak Holding/Axolin-Elinor; Peak Performance
- 93 CJEU 11 July 1996, cases C-427/93, C-429/93 and C-436/93, Bristol-Myers Squibb and Boehringer/ Paranova
- 94 CJEU 26 April 2007, C-348/04, Boehringer Ingelheim /Swingward
- 97 CJEU 22 December 2008, C-276/05, The Wellcome Foundation/Paranova

Other repackaging decisions

- 99 CJEU 11 November 1997, case C-349/95, Frits Loendersloot/Ballentine
- 99 CJEU 12 October 1999, case C-379/97, Upjohn/Paranova; Dalacin
- 99 CJEU 23 April 2002, case C-443/99, MSD/Paranova
- 99 CJEU 23 April 2002, case C-143/00, Boehringer/Swingward

PARALLEL TRADE WITHIN THE EEA

- 100 CJEU 13 July 1966, cases 56-58/64, Grundig, Consten/EC; Gint
- 100 CJEU 31 October 1974, case 16/74, Centrafarm/Winthrop; Negram
- 100 CJEU 22 June 1976, case 119/75, Terrapin/Terranova
- 100 CJEU 22 June 1994, case C-9/93, IHT Danziger/Ideal Standard
- 101 CJEU 23 October 2003, case C-115/02, Administration des douanes/Rioglass

GENUINE USE

- 102 Ansul/Ajax (real commercial exploitation)
CJEU 11 March 2003, case C-40/01, Ansul/Ajax; Minimax
- 103 La Mer (a real commercial purpose)
CJEU 27 January 2004, case C-259/02, La Mer Technology/Laboratoires Goemar; Laboratoire de la mer
- 104 Vitafruit (no de minimis rule)
CJEU 11 May 2006, case C-416/04 P, The Sunrider/OHIM; Vitafruit
- 105 Armin Häupl/Lidl Stiftung (normal use)
CJEU 14 June 2007, C-246/05, Armin Häupl/Lidl Stiftung
- 106 Radetzky (genuine use)
CJEU 9 December 2008, C-442/07, Radetzky-Orden/Kameradschaft Radetzky
- 107 Silberquelle/ Maselli-Strickmode (genuine use)
CJEU 15 January 2009, C-495/07, Silberquelle/ Maselli-Strickmode GmbH
- 108 Onel/Omel (territorial scope of use)
CJEU 19 December 2012, C-149/11, Leno/Hagelkruis

Other cases

- 109 CJEU 25 October 2012, C-553/11, Bernhard Rintisch/Klaus Eder; Proti
- 109 CJEU 18 April 2013, C-2/12, Colloseum /Levi Strauss
- 109 CJEU 18 July 2013, C-252/12, Specsavers/Asda

BAD FAITH

- 110 Lindt & Sprüngli/Frans Hauswirth
CJEU 11 June 2009, C-529/07, Lindt & Sprüngli/Frans Hauswirth
- 111 Malaysia Dairy (bad faith)
CJEU 27 June 2013, C-320, Malaysia Dairy/ Ankenævnet for Patenter og Varemærker; Yakult

LOSS OF DISTINCTIVE CHARACTER

- 112 Bostongurka (perception of the end user)
CJEU 29 April 2004, case C-371/02, Björnekulla/Procordia; Bostongurka
- 113 Levi Strauss/Casucci (time of assessment)
CJEU 27 April 2006, case C-145/05, Levi Strauss/Casucci; over stitching

OTHER USE OF A TRADE MARK

- 114 Robelco/Robeco (use as trade name)
CJEU 21 November 2002, case C-23/01, Robelco/Robeco

TERRITORIAL SCOPE PROHIBITIONS

- 115 DHL/Chronopost (territorial scope)
CJEU 12 April 2011, C-235/09, DHL/Chronopost

COMPARATIVE ADVERTISING

- 116 Toshiba/Katun (reference to product numbers)
CJEU 25 October 2001, case C-112/99, Toshiba/Katun; OEM-numbers
- 117 Pippig/Hartlauer (use of a competitor's logo)
CJEU 8 April 2003, case C-44/01, Pippig/Hartlauer
- 118 Siemens/Vipa (use of identical order numbers)
CJEU 23 February 2006, case C-59/05, Siemens/VIPA
- 119 Lidl/Colruyt (comparative advertising relating to the prices of a products selection)
CJEU 19 September 2006, C-356/04, Lidl/Colruyt
- 121 O2 Holdings/Hutchison 3G UK (comparative advertising)
CJEU 12 June 2008, C-533/06, O2 Holdings/Hutchison 3G UK

122 Lidl/Vierzon (comparison of price)
[CJEU 18 November 2010, C-159/09, Lidl/Vierzon](#)

AVERAGE CONSUMER

123 Gut Springenheide (average consumer)
[CJEU 16 July 1998, case C-210/96, Gut Springenheide/Steinfurt](#)

CUSTOMS REGULATION

124 Philips and Nokia (no manufacturing fiction in case of transit)
[CJEU 1 December 2011, C-446/09 en C-495/09, Philips en Nokia](#)

TRIPS

125 Hermès/FHT (provisional matters)
[CJEU 16 June 1998, C-53/96, Hermès/FHT](#)

126 Budweiser (trade mark vs trade name under TRIPs)
[CJEU 16 November 2004, case C-245/02, Anheuser Busch/Budějovický Budvar; Budweiser](#)

